

NEIFELD DOCKET NO: CAT29US-SCRCO3



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 6599

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/756,788

FILING DATE: January 10, 2001

GROUP ART UNIT: 3622

EXAMINER: JANVIER

TITLE: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 THIRD SUPPLEMENTAL APPEAL BRIEF AND REQUEST FOR  
REINSTATEMENT OF THE APPEAL

Sir:

In response to the non-final office action mailed April 18, 2005 imposing a restriction requirement, the applicants reinstate the appeal and file this third supplemental appeal brief, pursuant to 37 CFR 41.37.



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**I. 37 CFR 41.37**

This brief sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

**II. 37 CFR 41.37(b)**

The filing is timely. Accordingly, this subsection is not relevant.

**III. 37 CFR 41.37(c)(1)**

**A. 37 CFR 41.37(c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Delaware corporation.

**B. 37 CFR 41.37(c)(1)(ii) Related Appeals and Interferences**

Appeals are pending in the following related applications:

1. US Application No.: 09/478,351, filed October 8, 2002 (Neifeld Ref.: CAT/29-SCROCO2CP). The applicants filed an appeal brief September 11, 2003. The applicants filed a response to election of species requirement, a request for reinstatement of appeal, and a supplemental appeal brief on December 22, 2003. The applicants filed a second supplemental appeal brief May 20, 2004. The applicants filed a reply brief on August 24, 2004. Notification stating that the reply brief was forward to the Board was mailed on October 8, 2004.
2. Appeal Docket No.: 2004-1420. US Application No.: 09/567,274, filed May 9, 2000 (Neifeld Ref.: CAT/29-SCROCO3). The applicants filed an appeal brief January 28, 2003 and a substitute appeal brief on April 17, 2004. Examiner filed an answer to appeal brief on September 16, 2003. The applicants filed a reply brief on October 16, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-1420 on May 17, 2004. A decision on appeal was mailed on August 18, 2004. The applicants filed a request for rehearing on October 18, 2004. The Board of Patent Appeals and Interferences issued a decision on the request for rehearing on January 31, 2005. A Notice of Appeal to the United States Court of

Appeals for the Federal Circuit was filed on February 23, 2005. The Brief of the Appellants was filed with the Federal Circuit on June 17, 2005.

3. Appeal Docket No.: 2004-0989. US Application No.: 09/401,939 filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROCO). The applicants filed an appeal brief on March 14, 2003. The applicants filed a reply brief on September 17, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-0989 on February 15, 2004. A decision on appeal was mailed November 22, 2004. A decision on rehearing was mailed March 14, 2005. On April 7, 2005 the applicants filed a 37 CFR 1.114 Request for Continued Examination (RCE) transmittal.

4. Appeal Docket No.: 2004-0738. US Application No.: 09/401,198, filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROD1). The applicants filed an appeal brief on October 9, 2001. The applicants filed a reply brief July 1, 2002. The Board of Patent Appeals and Interferences assigned Appeal No. 2003-1733 on July 9, 2003. The Board remanded the case back to Examiner August 28, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-0738 on February 19, 2004. A decision on appeal was mailed November 30, 2004. The USPTO mailed a decision on rehearing February 10, 2005. This case is pending before the CAFC where it has been given the Appeal No. 05-1370.

5. US Application No.: 09/410,086, filed October 1, 1999 (Neifeld Ref.: CAT/29US-SCROD2). The applicants filed an appeal brief on July 24, 2002. The applicants filed a substitute appeal brief March 6, 2003. The Examiner's Answer was mailed on December 23, 2003. The applicants await a decision from the BPAI.

6. US Application No. 09/756,787, filed January 10, 2001 (Neifeld Ref.: CAT/29US-SCRCO2). A non-final office action was mailed on April 4, 2004. An amendment was filed on July 30, 2004. A non-final office action was mailed October 28, 2004. Notice of Appeal and Appeal Brief were filed on January 28, 2005. A Non-Final Rejection was issued on March 11,

2005. The applicants are requesting the appeal be reinstated and filing a new brief in the near future.

7. US Application No.: 90/005,888, filed December 12, 2000 (Neifeld Ref.: SCROREEX634). This reexamination is not yet under appeal. The applicants filed an amendment in reexamination and remarks in response to the notice regarding defective paper in ex parte reexamination on April 3, 2003. An office action was mailed from the PTO on January 30, 2004. An appeal brief was filed June 20, 2004. This appeal brief was refiled December 2, 2004. An office action in Ex Parte Reexamination was mailed from the PTO on May 10, 2005. The applicants have not yet responded.

**C. 37 CFR 41.37(c)(1)(iii) Status of Claims**

Claims 32-91 are pending, rejected, and under appeal.

**D. 37 CFR 41.37(c)(1)(iv) Status of Amendments**

All amendments are entered.

**E. 37 CFR 41.37(c)(1)(v) Summary of Claimed Subject Matter**

The invention of claim 32 is a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 3 lines 12-16, page 18 lines 27-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering purchasing incentives to consumers by e-mail (page 20 lines 17-19).

The invention of claim 38 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page

23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and a means for delivering by e-mail notices which remind consumers to visit said Web site (page 20 lines 17-19 and page 21 lines 25-27).

The invention of claim 44 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering by e-mail notices to purchase a specific manufacturer's product (page 20 lines 17-19).

The invention of claim 50 is the method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting purchase incentives via an e-mail post office (page 21 lines 4-8).

The invention of claim 54 is the method for delivering incentives over the Internet comprising the steps of: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-

mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office (page 21 lines 25-27).

The invention of claim 57 is a Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising: a personal database (page 22 lines 11-12); a purchase history database wherein the data on the consumer purchases are based on online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); means for generating a web page with a consumer-specific display (page 22 lines 16-18); means for updating said web page (page 20 lines 12-14 and page 23 lines 12-14); and means for informing the consumer by e-mail of new incentives (page 20 lines 2-4).

The invention of claim 58 is the method for delivery of incentives by e-mail, comprising the steps of: maintaining a consumer database which identifies consumers by their e-mail addresses; generating targeted purchase incentives from a consumer purchase history database; and formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon; and delivering the email message to an email address stored in said consumer database for said consumer (page 21 lines 4-9).

**F. 37 CFR 41.37(c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal**

Whether the rejections of claims 32-56 and 58-91 under 35 USC 102(e) based upon Jovicic et al. (US 5,855,007) [hereinafter Jovicic] are improper and should be reversed.

Whether the rejection of claim 57 under 35 USC 102(e) based upon Golden et al. (US 5,761,648) [hereinafter Golden] is improper and should be reversed.

**G. 37 CFR 41.37(c)(1)(vii) Argument**

**1. Rejections of Claims Under 35 USC 102(e) of Claims 32-56 and 58-91 as Being Anticipated by Jovicic et al. (US 5,855,007)**

**a. The Examiner's Argument**

In support of the rejections of claims 32-56 and 58-91 under 35 USC 102(e), the examiner asserts that:

Claims 32-56 and 58-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Jovicic et al. (US 5,855,007). Jovicic is considered to disclose a system or method comprising:

a web site for providing purchasing incentives from multiple sources (column 6 lines 4-48 wherein the disclosed Internet coupon notification center is considered to be patentably equivalent to the claimed multiple source web site purchase incentive);

a consumer purchase history database based on consumer online shopping activity (column 6 line 61 through column 7 line 61 wherein the disclosed electronic coupon redemption center accounting purpose is considered to implicitly anticipate claimed online purchase history database because redemption implies purchase history and accounting implies database shopping activity, column 7 line 66-67 expressly teaches the claimed online shopping purchase history because the disclosed shopping patterns of a particular user is considered to be based on shopping purchase history, and column 9 lines 19-28 wherein the disclosed past transaction recordation of coupon server database access implies an online consumer purchase history database because coupons associated with online shopping indicate history as claimed);

a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous and column 7 line 36 wherein the disclosed customer internet address or claimed consumer e-mail address is considered to be stored in a database);

receiving a consumer's e-mail address from a consumer's computer (column 8 lines 18-22 wherein the disclosed user self e-mailing is considered to expressly teach to consumer e-mail receipt);

maintaining a consumer email database which can identify consumers by their e-mail address (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous);

formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon (column 7 lines 45-55 wherein the disclosed internet coupon server electronic mail print out is considered to expressly anticipate the claimed e-mail formatting for coupon printing); and/or

means for delivering purchasing incentives or notices to purchase a specific manufacturer product to consumers by e-mail or means for delivering e-mail notices which remind consumers to visit the web site or transmitting purchase incentives via an e-mail post office or transmitting to consumers a notice to visit the web site via the consumer email address or generating targeted purchase incentives from a consumer purchase history database (column 7 lines 40-45 wherein the disclosed electronic mail message communication is considered to expressly disclose the claimed delivery means, reminder means, transmitting method, or generating method). Jovicic is also considered to disclose the claimed consumer profile (column 6 line 59), purchase history and consumer database integration (column 8 line 7), independently administered web site (column 10 line 34), cooperative site (column 10 line 36), past purchasing activity (column 7 line 66), shopping list selection data (column 8 line 50), rebate offer data (column 2 line 37), manufacturer or retailer web site links (column 7 line 58), product or sample information request (column 7 line 65), consumer favorite brands (column 6 line 59), customer identification number or name storage (column 7 line 27), demographic information (column 1 line 63), targeted time phased incentives based on consumer actual buying patterns and preferences (column 8 line 19), generating untargeted incentives (column 1 line 61), printed data enabling coupons (column 7 line 47), point of sale printing (column 2 line 64), token encoding identification card (column 7 line 27), shopping list

selections (column 6 line 50), and particular consumer specific offers (column 6 line 60). [Office action mailed May 4, 2004 page 2 line 5 through page 5 line 7.]

**b. The Applicants' Response**

In reply, the applicants respectfully submit that rejections of claims 32-56 and 58-91 under 35 USC 102(e) based upon Jovicic are improper and should be reversed because (1) these rejections are not supported by substantial evidence and (2) these rejections fail to carry the burdens of proof and persuasion.

**1. Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 “a web site for providing purchasing incentives from *multiple sources*”**

The examiner asserts that “Jovicic is considered to disclose a system or method comprising a web site for providing purchasing incentives from multiple sources.” The examiner further asserts that “...the disclosed internet coupon notification center is considered to be patentably equivalent to the claimed multiple source web site purchase incentive.” In summary reply, the applicant submits that Jovicic’s “internet coupon notification center” is not the claimed “web site for providing purchasing incentives from multiple sources,” as will be shown below.

In support of the assertion that “Jovicic is considered to disclose a system or method comprising a web site for providing purchasing incentives from multiple sources,” the examiner cites column 6 lines 4-48 in Jovicic, which states that:

As shown in FIG. 1, the Internet node 102 is coupled to an Internet Coupon Server 124 via Internet 122. The Internet Coupon Server 124 is any general purpose digital computer which serves as an "Internet Host" as described in the Internet Protocol RFC 791, and contains electronic coupons 300 and would preferably include a user database 126 which would keep track of the individual users registered with the Internet Coupon Server, a browsing memory 128 where representative coupon or coupons are stored and ready for selection by users, and

a coupon database 130 which will be more fully discussed below. In addition, The Internet Coupon Server 124, also includes Internet Coupon Notification Center Gateway 132 (ICNC gateway) for communicating with a plurality of Internet Coupon Notification Centers (ICNC) 134. The ICNC gateway 132 preferably also includes a computer database identifying interfacing information for accessing one or more ICNCs 134 through the interface. ICNC 134 could be either communicating with the ICNC gateway 132 over public computer network such as the Internet 122, as shown in FIG. 1 or physically present within the Internet Coupon Server. Each ICNC 134 is the owner of one particular category of coupons, for example a "Ben & Jerry's Inc." coupon category which gives \$0.25 discount on "Ben & Jerry's Vanilla Bean Ice Cream", and could comprise a coupon generation data base 136 for storing data about electronic coupons generated by the Internet Coupon Server 124, a coupon redemption database 138 for storing data about electronic coupons redeemed by users, general message database 140 for storing messages of general nature, and optionally, a printing device which records coupon transactions. Periodically, the ICNC 134 can communicate with the Internet Coupon Server 124, such as by the Internet Coupon Notification Center Gateway 132, and update Internet Coupon Server's Coupon Database 130, regarding the discount value of the coupon, number of coupons available, and coupon specifications. In this way, the Internet Coupon Server can maintain current information on electronic coupons 300 available to consumers. Typically, these consumers would be users of computing devices that are connected into public computer networks such as the Internet 122. As new providers of coupons become members of the electronic coupon communication system 100, they can establish ICNCs 134 and make their electronic coupons available to consumers over the Internet Coupon Server 124.

For at least the following reasons, the applicants submit that the cited passage in Jovicic does not disclose or suggest "a web site for providing purchasing incentives from *multiple sources*," as recited by claims 32, 38, 44, 50, and 54.

As to the meaning of “multiple sources,” this application states at page 3 lines 12-16 that:

The purchasing incentive offers in the presently preferred embodiment of the invention are derived from two sources: product manufacturers and retailers. The manufacturers’ incentives are presented to the customer in the form of a convenient index that the customer can browse through and select from. Similarly, retail supermarkets provide the source of another set of special offers, organized by store.

In addition, respecting both the Figure 1 and 13 embodiments, the specification states at page 18 lines 27-29 that:

A user 308 logs on to the server 300 through the network 304 and selects from a variety of offers stored on the storage device 306 by manufacturers and retailers.

Thus, the specification defines “multiple sources” to mean multiple retailers and/or manufacturers.

In contrast, Jovicic discloses its internet coupon notification center means an “internet coupon notification center” is not “owner of a *particular category* of coupons.” Jovicic column 6 lines 24-25. Therefore, Jovicic’s disclosed “web site for providing purchasing incentives from *multiple sources*” as defined by independent claims 32, 38, 44, 50, and 54. Therefore, independent claims 32, 38, 44, 50, and 54 patentably define over Jovicic. Therefore, the rejections of independent claims 32, 38, 44, 50, and 54 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

Dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 depend from independent claims 32, 38, 44, 50, or 54. The rejections of dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

2. **Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 “a consumer purchase history database” and “online shopping activity”**

The examiner asserts that Jovicic is considered to disclose a system or method comprising “a consumer purchase history database based on consumer online shopping activity.” The examiner further asserts that “wherein the disclosed electronic coupon redemption center accounting purpose is considered to implicitly anticipate the claimed online purchase history database because redemption implies purchase history and accounting implies database shopping activity.” The examiner is referring to Jovicic. In summary reply, the applicant submits that Jovicic discloses, with respect to databases, only that the user inputs demographic information during the initial process. As shown below, Jovicic does not disclose either (1) a consumer purchase history database or a database (2) based on consumer online shopping activity, as will be shown below.

The examiner cites column 6 line 61 through column 7 line 61 in Jovicic as allegedly disclosing that Jovicic is considered to disclose a system or method comprising “a consumer purchase history database based on consumer online shopping activity,” which states that:

The electronic coupon 300 also includes the product title 304 which bears indicia identifying the product to which the coupon applies, owner's title 306 which bears indicia identifying a particular person or company participating in the electronic coupon communication system 100, as well as the owner's coupon specification data 308 which bears indicia that communicate the coupon owner's instructions to the consumer and the coupon redemption center, regarding coupon redemption. Uniform product code 310 bears the standardized product code provided to the electronic coupon communication system 100 by the coupon's owner which serves his or her own accounting purposes. Similarly, digital representation of a graphical image of a bar code 312 is a standardized machine readable code provided to the electronic coupon communication system 100 by the coupon's owner which serves his or her own accounting purposes. Expiration

date 314 bears indicia indicating the expiration date of the coupon (if any). Furthermore, digital representation of a graphical image of the product 316 could bear a symbol, logo or an image related to the product graphically identifying the product. In addition, digital representation of the bar code's 312 and the product's 316 graphical image could utilize any of the image compression algorithms commonly used by general computing devices, such as the Joint Photographic Expert Group (JPEG) algorithm. Furthermore, electronic coupon 300 also contains a unique coupon serial number 318 generated by a coupon generation process 410 which identifies each particular electronic coupon 300 and plays an important role in marketing research and micro marketing techniques utilized by the coupon's owner. In the preferred embodiment of the invention, the electronic coupon 300 also contains customer's name data 320 bearing indicia pertaining to the name of coupon's user, customer's identification number (I.D.) 322 bearing customer I.D. assigned to the user by the Internet Coupon Server 124 during a registration process 408 having the customer's Internet address 324 and a personalized message 326 which bears a marketing message generated during the coupon generation process. Indicia pertaining to the coupon 302, 304, 306, 308, 310, 312, 314, 316 and 318 are stored in the coupon data base 130 before the coupon generation process 410 occurs. Indicia pertaining to customer's personal information 320, 322, 324 and 326 are stored in the user data base 126 before beginning the coupon generation process 410. After the coupon generation process 410, all indicia are stored, combined in the browsing memory 128 to represent an electronic coupon 300.

An electronic coupon 300 communicates a message to the user of the Internet node 102 when, for example, displayed on a viewing display 116 during the on-line session or stored in memory in the form of electronic mail 120, or when printed as a hard copy on user's printer 118.

A person can select an electronic coupon 300 from the Internet Coupon Server 124, print out a hard copy and redeem it at the coupon redemption center 142 (retail outlet) or the user could send the coupon using electronic mail from

the Internet Coupon Server 124 directly to the redemption center's general computing device connected into public computer network such as the Internet 122. The redemption center 142 would have an option to verify the legitimacy of the electronic coupon 300 by contacting coupon owner's ICNC 134 using various communication means.

According to the present invention, user's general computing device connected to the public network such as the Internet 122, establishes an on-line session with the Internet Coupon Server 124, preferably goes through the registration process 408 if the user is a new user, and then, after the coupon generation process 410 described in detail below,...

The examiner also states that "column 7 lines 66-67 expressly teaches the claimed online shopping purchase history because the disclosed shopping patterns of a particular user is considered to be based on shopping purchase history, and column 9 lines 19-28 wherein the disclosed past transaction recordation of coupon server database access implies an online consumer purchase history database because coupons associated with online shopping indicate history as claimed."

Column 7 lines 65-67 states that:

In the preferred embodiment of the invention, browsing is customized so that it suits the needs and shopping patterns of a particular user. By entering user input, such as through...

Column 9 lines 19-28 states that:

If the expiration date was not exceeded, the Internet Coupon Server records the transaction 510 in the field 11 which contains past transactions, by first storing customer's name, then customer's identification number and then the current coupon serial number. After the transaction is recorded, the Internet Coupon Server 124 notifies the transaction 512 over the Internet Coupon ICNC

gateway to the coupon owner's ICNC 134 by first sending customer's name 320, then customer's identification number 322 and then the current coupon serial number 318.

For at least the following reasons, the applicants submit that the cited passages in Jovicic do not disclose or suggest either (1) "a consumer purchase history database based on consumer online shopping activity," as recited by claims 32, 38, 44, and 50; or (2) "maintaining a consumer purchase history database based on consumer online shopping activity," as recited by claim 54.

Jovicic discloses, with respect to databases, only that the user inputs demographic information during the initial registration process. See column 9 lines 60-63, which states that:

Field 5 [Defined as "User demographic information" in Table 2 in Jovicic column 9 line 48.] bears indicia identifying user's demographic information which the Internet Coupon Server receives from the user during the initial registration process.

This registration information does not include either purchase information or online shopping activity. Moreover, Jovicic discloses demographics to mean region data or responses to marketing surveys, not purchase history information. Column 1 line 63 through column 2 line 1 of Jovicic states that:

While some demographic information can be obtained by noting the geographical regions in which the coupons were redeemed, the lack of any specific information as to the nature of the purchaser leads many manufacturers to conduct separate marketing surveys which are extremely costly and time consuming.

Moreover, Jovicic's other teachings are inconsistent with the examiner's conclusions as to Jovicic's teachings. The object of the invention, column 3 lines 1-6 in Jovicic, states that:

[T]o provide a coupon distribution and redemption system which can identify users of the system before they make coupon selections and offer different coupons to different users of the system before they make coupon selections on the basis of already-obtained demographic data about the users.

Thus, Jovicic is clearly directed to providing coupons, not purchases. Therefore, Jovicic does not disclose a consumer purchase history database.

Therefore, Jovicic does not disclose storing consumer purchase information. Accordingly, Jovicic does not disclose “a consumer purchase history database based on consumer online shopping activity,” as recited by independent claims 32, 38, 44 and 50; and “maintaining a consumer purchase history database based on consumer online shopping activity,” as recited by independent claim 54. Therefore, the rejections under 35 USC 102(e) based upon Jovicic are improper.

Since claims 32-56 and claims 58-91 either recite a “consumer purchase history database” or depend from a claim that recites a “consumer purchase history database,” the rejections of claims 32-56 and claims 58-91 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**3.     Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 “a consumer database which can identify consumers by their e-mail address”**

The examiner asserts that Jovicic is considered to disclose a system or method comprising “a consumer database which can identify consumers by their e-mail address.”

The examiner further asserts that “the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on applicants’ specification, it would be reasonable to broadly construe the terms as patentably synonymous,” and “the disclosed customer internet address or claimed consumer e-mail address is considered to be stored in a database.” In summary reply, the applicant submits that Jovicic does not disclose a consumer database which can identify consumers by their e-mail address. Jovicic only discloses

(1) that the user may be prompted to enter an email address and (2) that the Internet Coupon Server 124 mails the coupon electronically to the user, as will be shown below. What the examiner incorrectly assumed meant an email address (customer's internet address) is in fact a network address, not an email address. See Attachment 1.

In support of the assertion that Jovicic is considered to disclose a system or method comprising "a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said website so as to receive consumer data from said website," the examiner cites column 6 line 58 in Jovicic, which states that:

... number 322, customer's Internet address 324, and ...

In further support of the assertion that Jovicic is considered to disclose a system or method comprising "a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said website so as to receive consumer data from said website," the examiner cites column 7 line 36 in Jovicic, which states that:

... customer's personal information 320, 322, 324, and 326 are stored ...

For at least the following reasons, the applicants submit that Jovicic does not disclose or suggest "a consumer database which can identify consumers by their e-mail address," as recited by claims 32, 38, 44, 50, and 54.

Jovicic indicates that its server does not store user email addresses (1) by teaching in its preferred embodiment that the user may be prompted to enter an email address during an online session so that the Internet Coupon Server 124 can e-mail the coupon electronically to the user. See column 8 lines 10-17, which states that:

Once the user viewing the display 116 selects an electronic coupon 300 being displayed, such as by entering user input at the keyboard 114, the Internet Coupon Server 124 may ask the user to choose if the coupon is to be mailed

electronically, Internet Coupon Server 124 prompts the user to input an electronic mail address 418. When electronic mail address is inputed [sic], Internet Coupon Server 124 mails the coupon electronically to the addressee 420.

This indicates that Jovicic's server does not have an email stored in association with the user log in name in user database 126. This means that Jovicic does not disclose a "consumer database which can identify consumers by their e-mail address."

Jovicic indicates that its server does not store user email addresses (2) by disclosing the user database 126 fields, none of which stores a user email address, stating in Table 2 that the user data structure fields only include user name, user login name, user password, user identification number, user demographic information, and user customized message. Jovicic column 9 lines 42-50.

Moreover, Jovicic uses the term "customer's Internet address," which does not mean an email address. The term "internet address" is defined to mean "The 32-bit host address defined by the Internet Protocol in STD 5, RFC 791. It is usually represented in dotted decimal notation," which is not an email address. See Attachment 1, which is a copy of the definition of internet address, "Dictionary.com,

<http://dictionary.reference.com/search?q=internet%20address>.<sup>1</sup>

Column 7 lines 27-32 of Jovicic refers to the customer internet address, stating that:

... customer's identification number (I.D.) 322 bearing customer I.D. assigned to the user by the Internet Coupon Server 124 during a registration process 408 having the customer's Internet address 324 and a personalized message 326 which bears a marketing message generated during the coupon generation process.

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<sup>1</sup> Attachment 1 is a copy of the definition of internet address, "Dictionary.com, <http://dictionary.reference.com/search?q=internet%20address>."

Thus, contrary to the examiner's position, one of ordinary skill in the art would have recognized that Jovicic's reference to a customer's internet address meant an internet address. Therefore, Jovicic does not disclose identifying consumers by their e-mail addresses.

Therefore, Jovicic does not disclose "maintaining a consumer email database which can identify consumers by their e-mail address," as recited by claim 50; and Jovicic does not disclose "maintaining a consumer database which can identify consumers by their e-mail address," as recited by claim 54. Therefore, the 35 USC 102(e) rejections based upon Jovicic are improper. Therefore, the rejections of claims 50 and 54 under 35 USC 102(e) as being anticipated by Jovicic should be reversed.

Dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 depend from independent claims 32, 38, 44, 50, or 54. The rejections of dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

**4.     Claims 38, 54, and Dependent Claims 39-43 and 55-56**  
**"means for delivering e-mail notices which remind**  
**consumers to visit the web site"**

The examiner asserts that "Jovicic is considered to disclose a system or method comprising means for delivering e-mail notices which remind consumers to visit the web site." The examiner further asserts that "the disclosed electronic mail message communication is considered to expressly disclose the claimed delivery means, reminder means, transmitting method, or generating method." However, Jovicic does not disclose the content of the message. In support of the statement that "Jovicic is considered to disclose a system or method comprising means for delivering e-mail notices which remind consumers to visit the web site," the examiner cites column 7 lines 40-45 in Jovicic, which states that:

An electronic coupon 300 communicates a message to the user of the Internet node 102 when, for example, displayed on a viewing display 116 during the on-line session or stored in memory in the form of electronic mail 120, or when printed as a hard copy on user's printer 118.

For at least the following reasons, the applicants submit that the cited passage in Jovicic does not disclose or suggest (1) the content of the message, which is recited by the limitation “a means for delivering by e-mail notices which remind consumers to visit said Web site,” as recited in claim 38, or (2) the content of the message, which is recited by the limitation “transmitting to consumers a notice to visit the Web site via the consumer’s post office,” as recited in claim 54.

Jovicic does not disclose the content of the message and therefore, Jovicic does not disclose sending a notice to visit said Web site or to visit the Web site via the consumer’s post office. Moreover, Jovicic discloses that the electronic coupon is “stored in memory in the form of electronic mail 120,” however, Jovicic does not disclose the delivery means or transmitting method of this email message.

Therefore, Jovicic does not disclose “a means for delivering by e-mail notices which remind consumers to visit said Web site,” as recited by claim 38; and Jovicic does not disclose “transmitting to consumers a notice to visit the Web site via the consumer’s post office,” as recited by claim 54. Therefore, the rejections of independent claims 38 and 54 under 35 USC 102(e) based upon Jovicic are improper and should be reversed.

Dependent claims 39-43 and 55-56 depend from independent claims 38 or 54. The rejections of dependent claims 39-43 and 55-56 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

**5. Claim 54 and Dependent Claims 55-56 “transmitting to consumers a notice to visit the web site via the consumer email address”**

The examiner asserts that “Jovicic is considered to disclose a system or method comprising means for transmitting to consumers a notice to visit the web site via the consumer email address.” The support cited by the examiner is the same as that contained in section III.a.2.(d) above.

The applicants submit that the cited passage in Jovicic does not disclose or suggest the

content of the message, which is recited by the limitation “transmitting to consumers a notice to visit the Web site via the consumer’s e-mail post office,” as recited in claim 54.

Therefore, the rejection of independent claim 54 under 35 USC 102(e) as being anticipated by Jovicic is improper and should be reversed.

Dependent claims 55-56 depend from independent claim 54. The rejections of dependent claims 55-56 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claim 54 and should be reversed.

#### **6.     Claim 58 “generating targeted purchase incentives from a consumer purchase history database”**

The examiner asserts that “Jovicic is considered to disclose a system or method comprising means for generating targeted purchase incentives from a consumer purchase history database.” In support of this assertion, the examiner cites column 7 lines 40-45 in Jovicic, which is cited in section (f) above.

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest “generating targeted purchase incentives from a consumer purchase history database,” which is recited by claim 58.

The passage does not expressly disclose the claimed reminder means or generating method, as the examiner states. Moreover, the passage states that the message is “stored in memory in the form of electronic mail 120,” which does not expressly disclose the claimed delivery means or transmitting method. The passage does not disclose the content of the message, so it does not disclose a notice to generate targeted purchase incentives from a consumer purchase history database.

Jovicic does not disclose “generating targeted purchase incentives from a consumer purchase history database,” as defined by claim 58. Therefore, the rejection of claim 58 under 35 USC 102(e) as being anticipated by Jovicic is improper and should be reversed.

**7. Claims 34, 40, and 46 - The Claimed “purchase history and consumer database are integrated”**

The examiner asserts that “Jovicic is considered to disclose the claimed purchase history and consumer database integration.” In support of this assertion, the examiner cites column 8 line 7 in Jovicic, which states that:

... Coupon Server 124 sequentially transmit digitized pattern of ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “purchase history and consumer database integration,” which is defined by claims 34, 40, and 46.

As proven above, Jovicic does not disclose a consumer purchase history database. Therefore, Jovicic does not disclose the claimed “purchase history and consumer database integration,” as defined by claims 34, 40, and 46. Therefore, the rejections of claims 34, 40, and 46 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**8. Claims 35, 41, 47, 52, 55, 67, and 83 - The Claimed “independently administered web site”**

The examiner asserts that “Jovicic is considered to disclose the claimed independently administered web site.” In support of this assertion, the examiner cites column 10 line 34 in Jovicic, which states that:

... invention, the Internet node 102 will access Internet Coupon ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “independently administered web site,” which is defined by claims 35, 41, 47, 52, 55, 67, and 83.

The claimed independently administered web site is disclosed, for example, at page 5 line 28 through page 6 line 2 of the subject application, which states that:

Instead of being administered by or for a single commercial entity, the Web site through which customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

The passage that the examiner cites does not disclose the administration of a web site, it discloses the interaction between the Internet node 102 and the Internet Coupon Server's browsing memory 128 during the on-line session.

Jovicic does not disclose the claimed "independently administered web site," as defined by claims 35, 41, 47, 52, 55, 67, and 83. Therefore, the rejections of claims 35, 41, 47, 52, 55, 67, and 83 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

#### **9. Claims 36, 42, and 48 - The Claimed "cooperative site"**

The examiner asserts that "Jovicic is considered to disclose the claimed cooperative site." In support of this assertion, the examiner cites column 10 line 36 in Jovicic, which states that:

... over public computer network such as the Internet 122 using ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "cooperative site," which is defined by claims 36, 42, 48, 53, and 56.

The passage that the examiner cites does not disclose the claimed cooperative site, it discloses an interaction between the Internet node 102 and the Internet Coupon Server's browsing memory 128 during the on-line session. The use of a "public computer network such as the Internet" does not disclose a cooperative site.

The claimed "cooperative site" is disclosed, for example, at page 5 line 28 through page 6 line 2 in the subject application, which states that:

Instead of being administered by or for a single commercial entity, the

Web site through which customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

Jovicic does not disclose the claimed “cooperative site,” as defined by claims 36, 42, 48, 53, and 56. Therefore, the rejections of claims 36, 42, 48, 53, and 56 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**10. Claims 53 and 56 - The Claimed “step of providing a web site is achieved cooperatively”**

The examiner asserts that Jovicic is considered to disclose the claimed “step of providing a web site is achieved cooperatively.” In support of this assertion, the examiner cites column 10 line 36 in Jovicic, which states that:

... over public computer network such as the Internet 122 using ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “step of providing a web site is achieved cooperatively,” which is defined by claims 53 and 56.

The passage that the examiner cites does not disclose the claimed “step of providing a web site is achieved cooperatively,” it discloses an interaction between the Internet node 102 and the Internet Coupon Server’s browsing memory 128 during the on-line session. The use of a “public computer network such as the Internet” does not disclose the claimed “step of providing a web site is achieved cooperatively.”

The claimed “step of providing a web site is achieved cooperatively” is disclosed, for example, at page 5 line 28 through page 6 line 2 in the subject application, which states that:

Instead of being administered by or for a single commercial entity, the Web site through which customers communicate in accordance with the present

invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

This passage discloses that both retailers and manufacturers are able to combine their efforts, including information and incentives, to provide a beneficial website for customers, as defined in claims 53 and 56.

Jovicic does not disclose the claimed “step of providing a web site is achieved cooperatively,” as recited by claims 53 and 56. Therefore, the rejections of claims 53 and 56 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

#### **11. Claims 37, 43, and 49 - The Claimed “past purchasing activity”**

The examiner asserts that “Jovicic is considered to disclose the claimed past purchasing activity.” In support of this assertion, the examiner cites column 7 line 66 in Jovicic, which states that:

... customized so that it suits the needs and shopping patterns ...

In reply, the applicants submit that the passage that the examiner cites in Jovicic does not disclose or suggest the claimed “past purchasing activity,” which is defined by claims 37, 43, and 49.

The passage cited by the examiner is taken out of the context of the disclosure. Column 7 line 65 through column 8 line 2 in Jovicic states that:

In the preferred embodiment of the invention, browsing is customized so that it suits the needs and shopping patterns of a particular user. By entering user input, such as through the keyboard 114, the user can browse through the available coupons and make a selection of one coupon 300.

The passage discloses that the user has to enter input to customize the browsing, not that the user's past purchasing activity is involved.

Jovicic does not disclose the claimed "past purchasing activity," as defined by claims 37, 43, and 49. Therefore, the rejections of claims 37, 43, and 49 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**12. Claims 59 and 76 - The Claimed "shopping list selection data"**

The examiner asserts that "Jovicic is considered to disclose the claimed shopping list selection data." In support of this assertion, the examiner cites column 8 line 50 in Jovicic, which states that:

Structure (Table 1). Field 1 "Number of coupons available" ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "shopping list selection data," which is defined by claim 76.

Column 8 lines 48-53 in Jovicic states that:

Upon coupon selection 412, the transaction is recorded in the coupon data base 130, said data base containing Coupon Structure (Table 1). Field 1 "Number of coupons available" bears indicia providing information on the maximum number of electronic coupons the current unique coupon serial number 318 which makes a particular coupon unique.

This passage discloses information presented to the consumer after coupon selection, which does not disclose the claimed shopping list selection data. Moreover, the information in the Jovicic disclosure pertains to the number of coupons available, while shopping list selection data is disclosed in the subject application to present to the consumer such variables as store department and selected items within that department before the consumer makes a selection.

Jovicic does not disclose the claimed "shopping list selection data," as defined by claim

76. Therefore, the rejection of claim 76 under 35 USC 102(e) as being anticipated by Jovicic is improper and should be reversed.

**13. Claims 60 and 77 - The Claimed “rebate offer data”**

The examiner asserts that “Jovicic is considered to disclose the claimed rebate offer data.” In support of this assertion, the examiner cites column 2 line 37 in Jovicic, which states that:

... clearing, e) eliminate fraudulent redemptions of the type that ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “rebate offer data,” which is defined by claims 60 and 77.

The passage cited by the examiner relates to the redemption of coupons. Jovicic does not disclose the claimed “rebate offer data,” as defined by claims 60 and 77. Therefore, the rejections of claims 60 and 77 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**14. Claims 64 and 81 - The Claimed “manufacturer or retailer web site links”**

The examiner asserts that “Jovicic is considered to disclose the claimed manufacturer or retailer web site links.” In support of this assertion, the examiner cites column 7 line 58 in Jovicic, which states that:

Internet 122, establishes an on-line session with the Internet Coupon Server 124...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “manufacturer or retailer web site links,” which is defined by claims 64 and 81.

The Internet Coupon Server 124 is defined in Jovicic at column 6 lines 5- 8, which states that:

The Internet Coupon Server 124 is any general purpose digital computer which serves as an “Internet Host” as described in the Internet Protocol RFC 791.

Jovicic also discloses on column 6 lines 14-25 that the Internet Coupon Server 124 includes Internet Coupon Notification Center Gateway 132 and that each Internet Coupon Notification Center Gateway communicates with a plurality of Internet Coupon Notification Centers 134, each of which are the owners a particular coupon category. However, Jovicic does not disclose the claimed “manufacturer or retailer web site links,” as defined by claims 64 and 81. Therefore, the rejections of claims 64 and 81 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**15. Claims 65 and 82 - The Claimed “product or sample information request”**

The examiner asserts that “Jovicic is considered to disclose the claimed product or sample information request.” In support of this assertion, the examiner cites column 7 line 65 in Jovicic, which states that:

In the preferred embodiment of the invention, browsing is ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “product or sample information request,” which is defined by claims 65 and 82.

This passage discloses that the user has to enter input to customize the browsing and does not disclose the claimed “product or sample information request,” as defined by claims 65 and 82. Therefore, the rejections of claims 65 and 82 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**16. Claims 68 and 84 - The Claimed “consumer favorite brands”**

The examiner asserts that “Jovicic is considered to disclose the claimed consumer favorite brands.” In support of this assertion, the examiner cites column 6 line 59 in Jovicic, which states that:

... personalized message tailored to a particular customer.

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “consumer favorite brands,” which is defined by claims 68 and 84.

The passage cited in Jovicic discloses the inclusion of a personalized message in an electronic coupon. However, Jovicic does not disclose that its system is capable of retaining a consumer’s favorite brands. Therefore, the personalized message could not contain a consumer’s favorite brands, as disclosed in claims 68 and 84.

Jovicic does not disclose the claimed “consumer favorite brands,” as defined by claims 68 and 84. Therefore, the rejections of claims 68 and 84 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**17. Claims 69 and 85 “said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address”**

The examiner asserts that “Jovicic is considered to disclose the claimed customer identification number or name storage.” In support of this assertion, the examiner cites column 7 line 27 in Jovicic, which states that:

... coupon’s user, customer’s identification number (I.D.) 322 ...

In reply, the applicants submit that even if Jovicic disclosed a system or method comprising the claimed “customer identification number or name storage,” Jovicic would not

disclose “said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address,” which is defined by claims 69 and 85.

As proven above, Jovicic does not disclose a consumer purchase history database. Moreover, the “customer identification number and customer name” that the examiner claims is disclosed by Jovicic do not total the minimum three required elements as disclosed in claims 69 and 85.

Therefore, Jovicic does not disclose the claimed “said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address,” as defined by claims 69 and 85. Therefore, the rejections of claims 69 and 85 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**18.     Claims 70 and 86 “said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household”**

The examiner asserts that “Jovicic is considered to disclose the claimed demographic information.” In support of this assertion, the examiner cites column 1 line 63 in Jovicic, which states that:

While some demographic information can ...

In reply, the applicants submit that even if Jovicic disclosed a system or method comprising the claimed “demographic information,” Jovicic would not disclose “said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household,” which is defined by claims 70 and 86.

As proven above, Jovicic does not disclose a consumer purchase history database.

Moreover, the “demographic information” that the examiner claims is disclosed by Jovicic do not total the minimum two required elements as defined in claims 70 and 86.

Therefore, Jovicic does not disclose the claimed “said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household,” as defined by claims 70 and 86. Therefore, the rejections of claims 70 and 86 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**19. Claims 71 and 87 - The Claimed “targeted time phased incentives based on consumer actual buying patterns and preferences”**

The examiner asserts that “Jovicic is considered to disclose the claimed targeted time phased incentives based on consumer actual buying patterns and preferences.” In support of this assertion, the examiner cites column 8 line 19 in Jovicic, which states that:

... choose to e-mail the coupon to him or herself allowing him ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “targeted time phased incentives based on consumer actual buying patterns and preferences,” which is recited by claims 71 and 87.

The passage cited by the examiner discloses that a consumer, who is viewing a display of electronic coupons, can email the coupon to the consumer. This passage does not disclose targeted incentives, time-phased incentives, and the incentives are not based on consumer actual buying patterns and preferences; all of which are disclosed, for example, by the subject application at page 21 lines 10-13, which states that:

This approach allows producing targeted, time-phased incentives based on the customer’s actual buying patterns and preferences, and delivering them in the home prior to the customer’s shopping trip.

Jovicic does not disclose the claimed “targeted time phased incentives based on consumer actual buying patterns and preferences,” as defined by claims 71 and 87. Therefore, the rejections of claims 71 and 87 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**20. Claims 72 and 88 “generating untargeted incentives”**

The examiner asserts that “Jovicic is considered to disclose the claimed generating untargeted incentives.” In support of this assertion, the examiner cites column 1 line 61 in Jovicic, which states that:

... submitted anonymously, the manufacturer does not know ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed “generating untargeted incentives,” which is recited by claims 72 and 88.

The passage, in the Background of the Invention section, refers to the practice that coupons were submitted anonymously to consumers and the manufacturer did not know who had redeemed coupons, so the manufacturer could not market to the redeemers. This passage does not disclose “generating untargeted incentives,” which is disclosed, for example, by the subject application at page 21 lines 14-19, which states that:

The same delivery mechanism can be used to deliver untargeted or less targeted incentives from manufacturers, indicated at 518. The manufacturers may, for example, generate weekly offers, as shown in block 520, which the system delivers to selected consumers. Selection of consumers may be based on a customer profile or on demographic information maintained by the system administrator and selected by the manufacturer.

Jovicic does not disclose the claimed “generating untargeted incentives,” as defined by claims 72 and 88. Therefore, the rejections of claims 72 and 88 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**21. Claims 75 and 91 - The Claimed “token encoding identification card”**

The examiner asserts that “Jovicic is considered to disclose the claimed token encoding identification card.” In support of this assertion, the examiner cites column 7 line 27 in Jovicic, which states that:

... coupon's user, customer's identification number (I.D.) 322 ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest a token and therefore Jovicic does not disclose the claimed “token encoding identification card,” which is defined by claims 75 and 91 and is disclosed, for example, by the subject application at page 19 lines 8-12, which states that:

(b) The server 300 transmits the image of a token 316 of some kind to the user's computer 302. The token defines the coupon offer, preferably in coded form, such as in bar codes, but is not recognizable as a coupon. The token may, for example, be an encoded confirmation number. The user 308 presents the token 316 at the store he or she has selected, and receives the appropriate discount or promotion automatically.

Therefore, the rejections of claims 75 and 91 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

**22. Claims 59 and 76 - The Claimed “shopping list selections”**

The examiner asserts that “Jovicic is considered to disclose the claimed shopping list selections.” In support of this assertion, the examiner cites column 6 line 50 in Jovicic, which states that:

... preferably a combination of indicia and graphics which communicates ...

In reply, the applicants submit that the passage that the examiner cites discloses an electronic coupon. It does not disclose or suggest the claimed "shopping list selections," which is recited by claims 59 and 76 and is disclosed, for example, by the subject application at page 14 lines 13-20, which states that:

The shopping list maker is entered, as indicated in block 220, from the main menu, or from any of other various screens. The user may select a store department (block 222), such as meat, produce, and so forth, then select from displayed items sold in that department, as indicated in block 224. The selected items are added to the session record, as indicated in block 226, before a return is made to the main menu, as indicated in block 228. Items may be selected for adding to the shopping list whether or not any of the items is subject to a manufacturers' or supermarket special offer. Optionally, manufacturer and retailer offers may be displayed in the appropriate sections to alert the users of specials available.

Jovicic does not disclose the claimed "shopping list selections," as defined by claims 59 and 76. Therefore, the rejections of claims 59 and 76 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

### **23. Claims 61 and 78 - The Claimed "particular consumer specific offers"**

The examiner asserts that "Jovicic is considered to disclose the claimed particular consumer specific offers." In support of this assertion, the examiner cites column 6 line 60 in Jovicic, which states that:

... [The] discount information 302 bears indicia identifying a particular [value of the coupon].

In reply, the applicants submit that the passage that the examiner cites discloses does not disclose or suggest the claimed “particular consumer specific offers,” which is defined by claims 61 and 78.

As proven above, Jovicic does not disclose a consumer purchase history database. Therefore, Jovicic does not disclose the claimed “said consumer purchase history database comprises notices detailing specific offers data,” as defined by claim 61 and 78 and is disclosed, for example, by the subject application at page 21 lines 27-29, which states that:

Untargeted messages or notices can also be broadcast to large numbers of consumers to encourage them to visit a specific retail store, or to purchase a specific manufacturer’s product, or to visit the Web site.

Jovicic does not disclose the claimed “particular consumer specific offers,” as defined by claims 61 and 78. Therefore, the rejections of claims 61 and 78 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

Claim 61 depends from independent claim 32. Therefore, the rejection of claim 61 should be reversed for the same reasons as those reasons presented for claim 32.

Claim 78 depends from independent claim 50. Therefore, the rejection of claim 78 should be reversed for the same reasons as those reasons presented for claim 50.

#### **24. Claims 62, 66, and 79 - The Examiner did not Cite Support for Rejecting Claims 62, 66 and 79**

The examiner did not cite support for rejecting claims 62, 66 and 79, so the examiner’s rejections of claims 62 and 79 are improper and should be withdrawn.

**25. Claims 63 and 80 - The Examiner did not Cite Support for Rejecting Claims 63 and 80**

The examiner did not cite support for rejecting claims 63 and 80, so the examiner's rejections of claims 63 and 80 are improper and should be withdrawn.

**26. Claim 89 - The Examiner did not Cite Support for Rejecting Claim 89**

The examiner did not cite support for rejecting claim 89, so the examiner's rejection of claim 89 is improper and should be withdrawn.

**2. The Rejections Under 35 USC 102(e) of Claim 57 as Being Anticipated by Golden**

**a. The Examiner's Argument**

In support of the rejections of claims 32-91 under 35 USC 103(a), the examiner asserts that:

Claim 57 is rejected under 35 U.S.C. 102(e) as being anticipated by Golden et al. (US 5,761,648). Golden is considered to disclose a system or method comprising:

a personal database 2;

a purchase history database wherein the data on consumer purchases are based on consumer online shopping activity (column 4 lines 27-39 wherein the disclosed issuer coupon file data base with card check out activation online is considered to expressly teach the claimed online consumer shopping activity history database);

means for generating a web page with a consumer specific display (column 4 line 60 wherein the disclosed downloaded display by login password entry is considered to imply the claimed consumer specific web page display because a downloaded login would generate a specific consumer display);

means for updating said web page (column 5 line 7 wherein the disclosed

coupon update instructions is considered to expressly teach the claimed web page update means); and

means for informing the consumer by e-mail of new incentives (column 1 line 30 40 wherein the disclosed mail packs or mail lists when read in conjunction with the disclosed online electronic certificate is considered to imply the claimed informing means because new incentives to consumers inform via electronic means and mail means). [Office action mailed May 4, 2004 page 5 line 8 through page 6 line 7.]

**b. The Applicants' Response**

In reply, the applicants respectfully submit that this rejection is not supported by substantial evidence and it fails to carry the burdens of proof and persuasion. Therefore, the rejection of claim 57 under 35 USC 102(e) as being anticipated by Golden is improper and should be reversed.

**1. Claim 57 - the Examiner has not Shown that Golden Discloses a System or Method Comprising “a web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers”**

The examiner did not cite support for rejecting the limitation “a web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers.” Therefore, the rejection of claim 57 under 35 USC 102(e) as being anticipated by Golden is improper and should be reversed.

**2. Claim 57 “a purchase history database wherein the data on the consumer purchases are based on online shopping activity”**

The examiner asserts that “Golden is considered to disclose a system or method comprising a purchase history database wherein the data on the consumer purchases are based on online shopping activity.” The examiner cites column 4 lines 27-39 in Golden, which states that:

With the second method of redeeming a coupon, the consumer PC 2 transmits the selected coupon file 5 to a data base 7 designated by the issuer, where it is stored with the same information as the printed coupon, including the transaction and identification data. The check-out system at the retail outlet 8 would then automatically activate the discount if the consumer presented a store credit card or a third-party credit card and purchased the designated product. Preferably, the electronic transfer of the coupon from the consumer PC to data base 7 can only be done online. (This permits the service data base 2 to accurately track the coupon's printing or presentation activity, as discussed below.)

In further support of this passage, the examiner states "wherein the disclosed issuer coupon file data base with card check out activation online is considered to expressly teach the claimed online consumer shopping activity history database."

In reply, the applicants submit that the passage that the examiner cites in Golden does not disclose or suggest "a purchase history database wherein the data on consumer purchases are based on consumer online shopping activity," as recited by claim 57.

The passage that the examiner cites in Golden refers to a method of redeeming a coupon, whereby a customer can select coupons from the database and at the point of purchase and there is an electronic transfer of the coupon amount. Information pertaining to the selection of coupons for possible redemption does not constitute consumer purchase history data because selecting coupons are not a purchase.

Golden does not disclose "a purchase history database wherein the data on consumer purchases are based on consumer online shopping activity," as recited by claim 57. Therefore, the rejection of claim 57 under 35 USC 102(e) as being anticipated by Golden is improper and should be reversed.

3. **Claim 57 "means for generating a web page with a consumer-specific display"**

The examiner asserts that "Golden is considered to disclose a system or method

comprising means for generating a web page with a consumer-specific display.” The examiner cites column 4 line 60 in Golden, which states that:

...can be required). A main menu 12 is then displayed. Among...

In further support of this passage, the examiner states “wherein the disclosed downloaded display by login password entry is considered to imply the claimed consumer specific web page display because a downloaded login would generate a specific consumer display.”

In reply, the applicants submit that the passage that the examiner cites in Golden does not disclose or suggest “means for generating a web page with a consumer-specific display,” as recited by claim 57.

The passage that the examiner cites in Golden refers to a main menu that is displayed to a coupon issuer after the coupon issuer enters a login password. Claim 57 is directed to the consumer and not to a coupon issuer.

Moreover, the subject application discloses a personal consumer web site for providing a consumer with information and shopping incentives from multiple sources, which is disclosed, for example, at page 22 lines 2-3 and states that:

Another feature of the invention is the more direct targeting of incentives using a “personal page” for each consumer who wants one established.

In addition, there is nothing in the passage that relates the entry of a password by a coupon issuer to generating a display that is specific to any consumer. Therefore, the web page that is allegedly disclosed by Golden is not consumer-specific.

Furthermore, the examiner has provided no support to show that the main menu that is displayed in Golden constitutes a personal web page, which as disclosed, for example, in the subject application at page 22 lines 12-18, which states that:

The personal page displays a screen of information that is consumer-specific in many respects but will, of course, contain some data that is supplied to

all consumers who have personal pages. The page is preferably personalized with the consumer's name and may also contain the shopping list, if any, already generated by the consumer in the current online session. Significantly, the personal page will also contain offers and incentives targeted to the specific consumer, as further explained below.

Golden does not disclose "means for generating a web page with a consumer-specific display," which is recited by claim 57. Therefore, claim 57 patentably defines over Golden. Therefore, the rejection of claim 57 as being disclosed by Golden is improper and should be reversed.

#### **4. Claim 57 "means for updating said web page"**

The examiner asserts that "Golden is considered to disclose a system or method comprising means for updating said web page." The examiner cites column 5 line 7 in Golden, which states that:

[These changes are] used to update the coupon instructions 19 resident in the [service data base.]

In further support of this passage, the examiner states "wherein the disclosed coupon update instructions is considered to expressly teach the claimed web page update means."

In reply, the applicants submit that the passage that the examiner cites in Golden does not disclose the limitations defined by the recitation "means for updating said web page," as recited by claim 57.

As explained in the preceding section, Golden does not disclose or suggest "means for generating a web page with a consumer-specific display." Therefore, Golden cannot disclose "means for updating said web page," as recited by claim 57. Therefore, claim 57 patentably defines over Golden. Therefore, the rejection of claim 57 as being disclosed by Golden is improper and should be reversed.

**5. Claim 57 “means for informing the consumer by e-mail of new incentives”**

The examiner asserts that “Golden is considered to disclose a system or method comprising means for informing the consumer by e-mail of new incentives.” The examiner cites column 1 lines 30-40 in Golden, which states that:

The need arises for creation of an online "electronic certificate" that can be used for promotional or transactional purposes, much as coupons have been used in such traditional marketing vehicles as newspapers and mail packs. Beyond offering a discount as an incentive to buy a feature product, the coupon is also currency, printed in quantities limited by the issuer and often carrying unique serial numbers, expiration dates and "source codes" which indicate the means by which it was distributed (e.g. newspaper, mail list, in-store dispenser, etc.), so issuers can track the effectiveness of each marketing medium.

In further support of this passage, the examiner states “wherein the disclosed mail packs or mail lists when read in conjunction with the disclosed online electronic certificate is considered to imply the claimed informing means because new incentives to consumers inform via electronic means and mail means.”

In reply, the applicants submit that the passage that the examiner cites in Golden does not disclose or suggest “a system or method comprising means for informing the consumer by e-mail of new incentives,” as recited by claim 57.

Golden’s mail packs and mail lists are not email notifications of new incentives. Therefore, Golden does not disclose “a system or method comprising means for informing the consumer by e-mail of new incentives,” as recited in claim 57. Therefore, the rejection of claim 57 under 35 USC 102(e) based upon Golden is improper and should be reversed.

**H. 37 CFR 41.37(c)(1)(viii) Claim Appendix**

An appendix containing a copy of the claims involved in the appeal is attached as Appendix I.

**I. 37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

There is no evidence submitted pursuant to 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

**J. 37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix**

An appendix containing a copy of the decision on appeal for Application 09/567,274 mailed August 18, 2004 is attached as Appendix II. An appendix containing a copy of the decision on appeal for application 09/401,939 mailed November 22, 2004 is attached as Appendix III. An appendix containing a copy of the decision on appeal for application 09/401,198 mailed November 30, 2004 is attached as Appendix IV. An appendix containing a copy of the decision on request for rehearing for Application 09/567,274 mailed January 31, 2005 is attached as Appendix V. An appendix containing a copy of the decision on request for rehearing for application 09/401,939 mailed March 14, 2005 is attached as Appendix VI. An appendix containing a copy of the decision on request for rehearing for application 09/401,198 mailed February 10, 2005 is attached as Appendix VII.

**IV. 37 CFR 47.37 (c)(2)**

This brief does not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

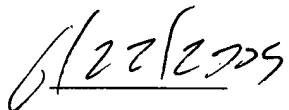
**V. 37 CFR 41.37 (d)**

This brief is in compliance with the requirements of paragraph (c) of this section. Accordingly, this section is inapplicable.

**VI. 37 CFR 41.37 (e)**

This appeal brief is filed timely. Accordingly, no extensions of time are necessary.

Respectfully Submitted,



Date

  
Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

BTM

Printed: June 22, 2005 (2:19pm)

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## Appendix I

32. A system for delivering incentives over the Internet comprising:  
a Web site for providing purchasing incentives from multiple sources;  
a consumer purchase history database based on consumer online shopping activity;  
a consumer database which can identify consumers by their e-mail addresses, wherein  
said consumer database is connected to said Web site so as to receive consumer data from said  
Web site; and  
means for delivering purchasing incentives to consumers by e-mail.
33. The system of claim 32 wherein said means for delivering purchase incentives  
delivers purchasing incentives based on consumer profile.
34. The system of claim 32 wherein the consumer purchase history database and  
said consumer database are integrated.
35. The system of claim 32 wherein said Web site is an independently administered  
Web site.
36. The system of claim 32 wherein said Web site is a cooperative site.
37. The system of claim 32 wherein said consumer purchase history database  
includes data based on past purchasing activity.
38. A system for delivering incentives over the Internet comprising:  
a Web site for providing purchasing incentives from multiple sources;  
a consumer purchase history database based on consumer online shopping activity;  
a consumer database which can identify consumers by their e-mail addresses, wherein  
said consumer database is connected to said Web site so as to receive consumer data from said  
Web site; and  
a means for delivering by e-mail notices which remind consumers to visit said Web site.
39. The system of claim 38 wherein said means for delivering e-mail notices  
delivers notices based on consumer profile.
40. The system of claim 38 wherein the consumer purchase history database and  
said consumer database are integrated.
41. The system of claim 38 wherein said Web site is an independently administered  
Web site.

42. The system of claim 38 wherein said Web site is a cooperative Web site.
43. The system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity.
44. A system for delivering incentives over the Internet comprising:
  - a Web site for providing purchasing incentives from multiple sources;
  - a consumer purchase history database based on consumer online shopping activity;
  - a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering by e-mail notices to purchase a specific manufacturer's product.
45. The system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile.
46. The system of claim 44 wherein the consumer purchase history database and the consumer database are integrated.
47. The system of claim 44 wherein said Web site is and independently administered Web site.
48. The system of claim 44 wherein said Web site is a cooperative Web site.
49. The system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity.
50. A method for delivering purchasing incentives over the Internet comprising the steps of:
  - providing a Web site which offers shopping incentives from multiple sources;
  - maintaining a consumer purchase history database based on consumer online shopping activity;
  - receiving a consumer's e-mail address from a consumer's computer;
  - maintaining a consumer email database which can identify consumers by their e-mail address; and
  - transmitting purchase incentives via an e-mail post office.
51. The method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer

profile.

52. The method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator.

53. The method of claim 50 wherein the step of providing a Web site is achieved cooperatively.

54. A method for delivering incentives over the Internet comprising the steps of: providing a Web site which offers purchasing incentives from multiple sources; maintaining a consumer purchase history database based on consumer online shopping activity;

receiving a consumer's e-mail address from a consumer's computer; maintaining a consumer database which can identify consumers by their e-mail address; and

transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

55. The method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator.

56. The method of claim 54 wherein the step of providing a Web site is achieved cooperatively.

57. A Web site for providing information and shopping incentives from multiple sources such as retailers and manufacturers comprising:

a personal database; a purchase history database wherein the data on the consumer purchases are based on online shopping activity; means for generating a web page with a consumer-specific display; means for updating said web page; and means for informing the consumer by e-mail of new incentives.

58. A method for delivery of incentives by e-mail, comprising the steps of: maintaining a consumer database which identifies consumers by their e-mail addresses; generating targeted purchase incentives from a consumer purchase history database; and formatting an e-mail message to a consumer by electronic mail for subsequent printing of

a coupon; and

delivering the email message to an email address stored in said consumer database for said consumer.

59. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises shopping list selections data.

60. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises rebate offers data.

61. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data.

62. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data.

63. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons for subsequent printing by a consumer.

64. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites.

65. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product.

66. The system of claim 32 wherein said consumer purchase history database stores data from any online shopping activity.

67. The system of claim 32 wherein said consumer purchase history database stores an administrator of said system's web site data.

68. The system of claim 32 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands data.

69. The system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address.

70. The system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

71. The system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

72. The system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers.

73. The system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer.

74. The system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale.

75. The system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives.

76. The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises shopping list selections associated with a particular consumer.

77. The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer.

78. The method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer.

79. The method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity.

80. The method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer.

81. The method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer.

82. The method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product.

83. The method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site.

84. The method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands.

85. The method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address.

86. The method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

87. The method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

88. The method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers.

89. The method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer.

90. The method of claim 50 further comprising printing purchase incentives at point of sale.

91. The method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives.

Printed: June 22, 2005 (2:19pm)

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**Attachment**

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[Premium: Sign up | Login](#)



ADVERTISEMENT

Dictionary - Thesaurus - Web

Get the Most Popular Sites for "internet address"**3 entries found for *internet address*.****internet address**

<networking> (IP address, TCP/IP address) The 32-bit host address defined by the Internet Protocol in STD 5, RFC 791. It is usually represented in dotted decimal notation.

A host's Internet address is sometimes related to its Ethernet address. The Internet address is usually expressed in dot notation, e.g. 128.121.4.5. The address can be split into a network number (or network address) and a host number unique to each host on the network and sometimes also

a subnet address. The way the address is split depends on its "class", A, B or C as determined by the high address bits:

Class A - high bit 0, 7-bit network number, 24-bit host number.  $n_1.a.a.a$   $0 \leq n_1 \leq 127$

Class B - high 2 bits 10, 14-bit network number, 16-bit host number.  $n_1.n_2.a.a$   $128 \leq n_1 \leq 191$

Class C - high 3 bits 110, 21-bit network number, 8-bit host number.  $n_1.n_2.n_3.a$   $192 \leq n_1 \leq 223$

The Internet address must be translated into an Ethernet address by either ARP or constant mapping.

The term is sometimes used incorrectly to refer to a host's

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Yahoo Domain Registration, Web page domain email, forwarding, \$14.70/yr  
[domains.yahoo.com](#)

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[www.IDotz.Net](#)

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Support, FAQs, Info Library, Free Wh Papers, Webinars & Roundtables.  
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fully qualified domain name.

[Jargon File]

(1994-12-06)

Source: The Free On-line Dictionary of Computing, © 1993-2004 Denis Howe

internet address

<networking> (Note lower case "i"). An IP address that uniquely identifies a node on an internet.

[Jargon File]

(1995-04-12)

Source: The Free On-line Dictionary of Computing, © 1993-2004 Denis Howe

internet address

n. 1. [techspeak] An absolute network address of the form `foo@bar.baz`, where `foo` is a user name, `bar` is a sitename, and `baz` is a 'domain' name, possibly including periods itself. Contrast with bang path; see also the network and network address. All Internet machines and most UUCP sites can now resolve these addresses, thanks to a large amount of behind-the-scenes magic and PD software written since 1980 or so.

See also bang path, domainist. 2. More loosely, any network address reachable through Internet; this includes bang path addresses and some internal corporate and government networks.

Reading Internet addresses is something of an art. Here are the four most important top-level functional Internet domains followed by a selection of geographical domains:

`com`



commercial organizations

edu

educational institutions

gov

U.S. government civilian sites

mil

U.S. military sites

Note that most of the sites in the com and edu domains are in the U.S. or Canada.

us

sites in the U.S. outside the functional domains

su

sites in the ex-Soviet Union (see kremvax).

uk

sites in the United Kingdom

Within the us domain, there are subdomains for the fifty states, each generally with a name identical to the state's postal abbreviation. Within the uk domain, there is an ac subdomain for academic sites and a co domain for commercial ones. Other top-level domains may be divided up in similar ways.

Source: Jargon File 4.2.0

Perform a new search, or try your search for "internet address" at:

- [Amazon.com](http://Amazon.com) - Shop for books, music and more
- [Reference.com](http://Reference.com) - Search the Web
- [eLibrary](http://eLibrary) - Search thousands of newspapers and magazines
- [Google](http://Google) - Search the Web for relevant results
- [Google Groups](http://Google Groups) - Search Usenet messages back to 1981
- [Merriam-Webster](http://Merriam-Webster) - Search for definitions

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6/19/04  
ES

# Appendix ~~II~~



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Review by Attorney: 8-26-04

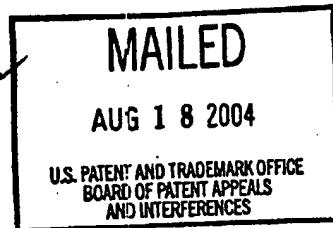
Reminder - Reg for Reconsideration: 9-18-04

File Reg for Reconsideration: 10-18-04

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, ✓  
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-1420 ✓  
Application No. 09/567,274 ✓

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on appeal from the twice-rejected claims

28-43.<sup>1</sup>

<sup>1</sup>The statement of the 35 U.S.C. § 103 rejection in both the answer and in Paper No. 19 indicates that the claims subject to this rejection are claims "34-43" with no indication that claims 28-33 have been rejected on this ground. However, since the body of the rejection in both the answer and in Paper No. 19 then goes on to indicate why claims 28-33 are rejected under 35 U.S.C. § 103, and appellants, by their arguments, clearly understand all

Dec App CITA95CPC03 040819 ES

Appeal No. 2004-1420  
Application No. 09/567,274

The invention relates to providing shopping incentives to customers through a computer network.

Representative of the sixteen independent claims is claim 28, reproduced as follows:

28. A method for distributing purchasing incentives to retail consumers over a computer network, said method comprising the steps of:

storing product purchase data pertaining to products purchased in association with an identification in a consumer purchase history database;

storing an electronic mail address in association with said identification in a consumer electronic address database;

generating a purchase incentive in response to said identification being provided over said computer network, based on said product purchase data and depending upon frequency of prior use of purchase incentives generated for said identification; and

transmitting said purchase incentive to said electronic mail address.

The examiner relies on the following reference:

Barnett et al. (Barnett) 6,336,099 Jan. 1, 2002  
(eff. filing date of Apr. 19, 1995)

---

of claims 28-43 to stand rejected under 35 U.S.C. § 103, we will treat claims 28-43 as standing twice rejected under 35 U.S.C. § 103 and on appeal herein.

Appeal No. 2004-1420  
Application No. 09/567,274

Claims 28-43 stand rejected under 35 U.S.C. § 103 as unpatentable over Barnett.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Appeal No. 2004-1420  
Application No. 09/567,274

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

It is the examiner's position, with regard to instant claims 34, 35, 38 and 39, that Figure 1 of Barnett is indicative of a system for distributing purchasing incentives to retail customers over a computer network wherein a database is configured to store product purchase data pertaining to products purchased in association with an identification in a consumer purchase history

database; and that Figure 9 and column 9, lines 59-67, teach a generation of an incentive based upon whether a signal containing the identification was received in a selected prior time period.

The examiner also indicates that Barnett teaches the storing of an electronic mail address in association with said identification in a consumer electronic database at column 13, lines 58-67. However, the examiner indicates that Barnett does not specifically teach transmitting the incentives to the electronic mail address. But, since "the e-mail address for the user is stored...it would have been obvious...to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user (col. 4, lines 25-29)" (answer-page 3).

Specifically, with regard to claims 28, 29, 32, 33, 40 and 41, the examiner finds that purchase incentives generated based upon frequency of redemption of online purchase incentives generated for said identification (see page 4 of the answer) would have been obvious in view of Barnett's disclosure at (Figures 1-9 and column 7, lines 35-55).

The examiner cites Figure 9 of Barnett as evidence of the obviousness of the limitations of claims 30 and 31 and the

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examiner cites Figures 1 and 9 of Barnett as evidence of the obviousness of the limitations of claims 36, 37, 42 and 43.

Appellants' position, with regard to claims 28, 29, 32 and 33 is that Figures 1-9 and column 7, lines 35-55 of Barnett do not disclose the claimed "generating said purchase incentive...based upon frequency of prior use of purchase incentives generated for said identification."

With regard to claims 30 and 31, appellants argue that Figure 9 of Barnett does not disclose the claimed "generating said purchase incentive for said identification based upon a frequency of prior use of an online system with said identification."

With regard to claims 34 and 35, appellants argue that Figure 9 of Barnett, column 6, lines 62-66, which describes this figure, and column 9, lines 59-67, do not disclose "generating an incentive based upon whether a signal containing said identification was received in a selected prior time period..."

With regard to claims 36 and 37, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive based on said product purchase data including whether said identification is associated with redemption of an online purchase incentive during a selected prior time period..."

With regard to claims 38 and 39, appellants argue that Figure 9 and column 9, lines 59-67, of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network, based at least in part upon frequency of selection of purchase incentives generated for said identification."

With regard to claims 40 and 41, appellants argue that Barnett does not disclose the concept of generating a purchase incentive at least in part on frequency of redemptions of online purchases generated for an identification.

With regard to claims 42 and 43, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network and based at least in part upon whether said identification is associated with selection of an online purchase incentive during a selected prior time period..."

With regard to all of the claims, 28-43, appellants argue that column 13, lines 58-67, of Barnett, does not disclose "storing an electronic mail address in association with said identification in a consumer electronic database." It is appellants' view that it would not have been obvious to store an electronic mail address in association with said identification

in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

We AFFIRM.

It appears to us that the examiner has set forth a reasonable case, identifying claim limitations and pointing out where, in the reference, such limitations can be found or why the claimed subject matter would have been obvious in view of specific teachings of Barnett. Thus, we find that the examiner has established a prima facie case of obviousness.

Yet, appellants' main response is that Barnett "does not disclose" some limitation quoted from the claims. However, appellants do not explain why they take these positions in view of the examiner's rationale. It is not enough for appellants to merely state that the reference does not disclose something when the examiner has pointed out where and how the reference is considered to have disclosed something or to have made that something obvious. 37 CFR 1.192(c)(8)(iv) requires appellants' arguments to specify the errors in the rejection and, if

appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art" (emphasis added).

Appellants get somewhat specific with regard to the storing of an electronic mail address in association with said identification in a consumer electronic database by arguing that it would not have been obvious to store an electronic mail address in association with said identification in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

However, we agree with the examiner that while Barnett may not specifically teach the claimed storing of an electronic mail address in association with said identification in a consumer electronic database, it would have been obvious to do so. This is so because Barnett clearly teaches storing a user's e-mail Internet address (column 13, lines 62-65) and since the online

system maintains the user's e-mail Internet address, it would have been clearly obvious to associate a particular user with his/her particular e-mail address and to use such address for any desired transmission to a user.

We note that appellants do not address the obviousness of providing for the claimed storing of an electronic mail address in association with said identification in a consumer electronic database. They merely argue that the reference does not disclose this. It should be noted that this is not an anticipation rejection based on 35 U.S.C. 102, but rather an obviousness rejection based on 35 U.S.C. § 103. Accordingly, the mere allegation by appellants that the applied reference does not disclose a particular claim limitation is not dispositive of the issue of obviousness. Appellants must explain, in view of the examiner's reasonable rationale, why the claimed subject matter would not have been obvious, i.e., appellants must point out the alleged errors in the rejection. This, appellants have not done.

In the reply brief, appellants get more specific regarding the argument that the reference does not disclose the "frequency" limitation. That is, in reviewing column 7, lines 35-55, of Barnett, appellants argue that while the coupon distribution center 16 utilizes the user-specific redemption data, along with

user-specific demographic data supplied by the online service provider 2, this passage does not disclose generating a purchase incentive based at least in part upon frequency of use or redemption of incentives.

We agree with appellants that Barnett does not specifically disclose generating the incentive based at least in part upon frequency of use or redemption. But, again, the rejection is based on obviousness under 35 U.S.C. § 103, rather than anticipation. The reference does not need to specifically disclose the generation of incentives based at least in part upon frequency of use or redemption, as long as there is some suggestion to do so or something that would have led the artisan to base the incentive generation at least in part upon frequency of use or redemption.

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic

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data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.

Accordingly, appellants' arguments are not persuasive of unobviousness and fail to overcome the prima facie case of obviousness established by the examiner.

The examiner's decision rejecting claims 28-43 under 35 U.S.C. § 103 is affirmed.

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Application No. 09/567,274

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

*Errol A. Krass*  
ERROL A. KRASS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

*Michael R. Fleming*  
MICHAEL R. FLEMING  
Administrative Patent Judge

BOARD OF PATENT  
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Appeal No. 2004-1420  
Application No. 09/567,274

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PB

# Appendix ~~II~~ ~~III~~ III

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 29

## UNITED STATES PATENT AND TRADEMARK OFFICE

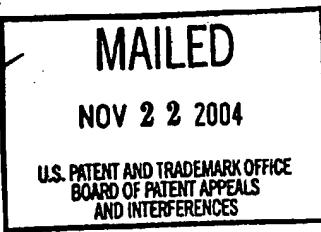
### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Atty Review: 12-9-04

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA, ✓  
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0989  
Application No. 09/401,939

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-70.

The invention is directed to providing shopping aids and incentives to customers through a computer network. In particular, purchasing incentives are distributed to a consumer by transmitting promotion data identifying a plurality of product

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discounts from a main computer to the consumer's computer and displaying the plurality of product discounts at the consumer's computer based on the promotion data. Selection data designating at least one product discount selected from the plurality of product discounts is then transmitted from the consumer's computer to the main computer.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

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determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

The examiner relies on the following references:

Day et al. (Day)	5,857,175	Jan. 5, 1999
Scroggie et al. (Scroggie)	5,970,469	Oct. 19, 1999 (filed Mar. 26, 1996)

Claims 32-70 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as relying on a disclosure lacking enablement and a written description, and as being vague and indefinite.

Claims 32-70 stand further rejected under 35 U.S.C. § 102(b) as anticipated by Day.

Claims 32-70 stand further rejected under 35 U.S.C. § 103 as "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike" (answer-page 5).

Claims 32-70 stand still further rejected under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469 to Scroggie.

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Claims 32-70 stand even still further rejected under 35 U.S.C. § 103 "over copending US Patent Application 09/567,274" (answer-page 8).<sup>1</sup>

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We turn, first, to the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph.

The examiner contends that the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are "not enabled by the specification." The examiner also contends that the inventors did not have possession of the claimed invention at the time of filing because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to

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<sup>1</sup>While the examiner indicates the rejection is based on "prior art" in stating that the rejection is under 35 U.S.C. § 103, it is clear from the examiner's explanation, especially, at the bottom of page 15 in the answer, that the rejection is really a provisional rejection based on obviousness-type double patenting.

a main computer over a computer network and generating token data depending on selection data.

It is the examiner's position that these claimed features are not enabled by the instant specification since the "examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention" such that skilled artisans could make and use the invention.

The examiner's position regarding the rejection of the claims under 35 U.S.C. § 112, first paragraph, is unreasonable and we will not sustain these rejections.

As a matter of Patent and Trademark Office practice, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of 35 U.S.C. 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching

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contained in the specification is truly enabling, In re Marzucchi, 439 F.2d 220, 169 USPQ 367 (CCPA 1971); In re Sichert, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977).

When a rejection is made on the basis that the disclosure lacks enablement, it is incumbent upon the examiner to explain why he doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions with acceptable evidence or reasoning which is inconsistent with the contested statement. The examiner has not advanced any such evidence or an acceptable line of reasoning inconsistent with enablement and, therefore, has not sustained his burden.

Not only has the examiner not set forth any reasonable basis for challenging the sufficiency of disclosure, asserting, without explanation, that he deems the claimed features to be merely "concepts that cannot be practically applied" (answer-page 4), but it appears to us that the claimed features of "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" merely entail programming web sites to provide the functionality claimed. This functionality of transmitting data selected from a plurality of

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choices and generating other data in dependence on the selection data does not appear to us to be anything out of the ordinary for the skilled web programmer and would not entail any undue experimentation on his/her part.

Accordingly, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first paragraph, based on non-enablement.

With regard to written description, we also will not sustain the rejection of claims 32-70 on this ground.

The examiner again points to the claim language, "transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network" and "generating token data depending on said selection data" and, now, alleges that since the specification does not discuss these claimed features, it is not considered that the applicants had possession of what they now claim as their invention at the time of filing the instant application.

Appellants point to page 9, lines 4-5, of the instant specification for a disclosure of a customer selecting a coupon offer from a plurality of offers after log-in and switching to an offer browser.

With regard to "generating token data...," appellants point to page 24, lines 2-6, of the specification. Since this portion of the specification states that

Generating a "token" instead of coupon, as described above with reference to FIG. 13, also reduces the risk of fraud. Another technique similar to this is depicted in FIG. 18. A token 316 is generated by the user's computer 302 after interaction with the distribution sever 300. The user chooses from incentive offers as described above, but instead of a coupon the computer 302 generates the token 316,

it is clear to us that applicants did, indeed, have possession of the invention which they now claim.

Thus, we will not sustain the rejection of claims 32-70 under the written description clause of 35 U.S.C. § 112, first paragraph.

Turning to the rejection of the claims under 35 U.S.C. § 112, second paragraph, the examiner alleges that the claims are indefinite because there is no antecedent basis for "transmitting selected data" or "generating token data" in the claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over said computer network and generating token data depending on said selection data. The examiner also alleges that the instant specification also does

not provide an antecedent basis for these claim limitations.

First, we point out that the second paragraph of 35 U.S.C. § 112 is directed to the claims, not the specification. We may look to the specification to give meaning to an otherwise misunderstood claim limitation but the claims themselves must provide the antecedent basis for the specific claimed steps/elements.

Moreover, the inquiry under 35 U.S.C. 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In the instant case, taking claim 32 as exemplary, the steps of "transmitting selection data..." and "generating a token data..." are first time recitations within the claim and the recited steps themselves provide the antecedent basis for the steps. Thus, the examiner's concern for "antecedent basis" is not understood. It is not as if the claims recited "said step of

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transmitting selection data..." and never previously recited such data.

Accordingly, we find that the examiner's rejection under 35 U.S.C. § 112, second paragraph, has no basis, in fact. The claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity and, as such, are in accordance with 35 U.S.C. § 112, second paragraph. The examiner has failed to reasonably show any indefiniteness within the claims.

Thus, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, second paragraph.

The examiner's next rejection deals with anticipation of the claims under 35 U.S.C. § 102(b) over Day.

A claim is anticipated only when a single prior art reference expressly or inherently discloses each and every element or step thereof. Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). If the examiner presents a reasonable basis for alleging inherency, the burden shifts to appellant to come forward, if they can, with evidence to the contrary. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Ludtke, 441

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F.2d 660, 169 USPQ 563 (CCPA 1971); In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

It is the examiner's position that claims 32-70 are "clearly anticipated" by Day, without any explanation in the statement of the rejection at page 5 of the answer.

In response to appellants' arguments, the examiner explains his position, at pages 11-14 of the answer. That position is that column 1, line 64 through column 2, line 5, and column 3, line 20, anticipates all of the claimed subject matter with regard to the independent claims.

The examiner basically relies on the background section of Day, wherein is described an in-store terminal which a consumer may access. A list of coupons is presented to the consumer, and a link between the terminal and check-out stations in the store permits discounts selected by the consumer to be subtracted from the total bill on check-out.

We would agree that, given the broadest, reasonable interpretation of "personal computer," "computer network" and "main computer," one might consider the in-store terminal described in Day as a "personal computer" since it is used by the consumer. One may even consider the link between the terminal and the check-out stations to be part of a "computer network."

Possibly, the main check-out stations might constitute the claimed "main computer."

However, it is not clear from the description in Day, or from the examiner's explanation, that the main computers (i.e., the main check-out stations) are actually transferring the promotion data to the personal computer (i.e., the consumer terminals). The instant claims require the main computer to transfer promotion data identifying a plurality of product discounts to a personal computer over a computer network.

But, even if we assume that the check-out stations described in the cited portions of Day do, in fact, transmit the promotion data to the customer terminal and even if we assume, then, that Day would teach the claimed steps of "transmitting promotion data...," "displaying said plurality of product discounts..." and "transmitting selection data...," the examiner's case would still fail because the instant claims all require an element/step of "generating token data depending on said selection data."

The examiner's rationale is that this generation of token data is "considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the

disclosed discount subtraction" (answer-page 12), referring to lines 3-4 of column 2 in Day.

The cited portion of Day refers to "discounts selected by the consumer." This may be equivalent to the claimed "...at least one product discount selected..." in the "transmitting selection data..." paragraph of claim 32, for example. But, this cited portion of Day cannot then also serve as disclosing the next claimed step of "generating token data depending on said selection data" because it is only after the selection is made that a token, depending on said selection data, can be generated.

Moreover, we do not see how the generation of such token data can be "implicit" as urged by the examiner.

The examiner has pointed to nothing in the Day disclosure which even suggests the claimed generation of "token data." Without a teaching of this token data, Day cannot identify any such token data or determine discount items being purchased from undisclosed token data.

Accordingly, since the examiner's rationale fails to convincingly point, in the applied reference, to the claimed "token data," the examiner has failed to establish a prima facie case of anticipation and we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 102(b).

We do point out, in passing, however, that should the examiner have convinced us of a teaching of such "token data" in Day, appellants' arguments would have been insufficient to overcome such a prima facie case since appellants merely argue that Day does not disclose what is recited in the claims, without specifically pointing out any perceived errors in the examiner's position, and without specifically identifying particular claimed features which are considered to distinguish over Day.

Nevertheless, since the burden to establish a prima facie case of anticipation rests initially on the examiner, and, in our view, the examiner clearly failed to meet that burden in this case, we do not reach appellants' arguments.

The examiner's next rejection, under 35 U.S.C. § 103, is based on "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike."

The examiner contends that since "at least 1994, PerformanceBike has performed the claimed method, system and program..." The examiner states that he

has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token

use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased... The claimed invention...has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known...to claim the invention as recited by the applicant by substituting terms with patentably equivalent claim language, in order to overcome the explicit teachings of the examiner's experienced prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious...to provide a personal computer display since the computer display is merely an automated feature of a concept that is old and well known... It is considered that the claim recitations using "computer" are an attempt to automate an old and well known process provided by PerformanceBike... (answer-pages 6-7).

Appellants argue, at pages 15-20 of the principal brief, that the PerformanceBike website has not been established as

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Application No. 09/401,939

prior art and the examiner has offered no physical evidence to support the examiner's assertions.

We have considered the examiner's assertions and appellants' arguments thereagainst and we conclude that the examiner has simply not established that his experience with PerformanceBike would constitute a prima facie case of obviousness against the instant claimed subject matter. Without physical evidence and/or a more detailed written description as to how the PerformanceBike retail system works, we are not persuaded by the examiner's declaration of experience that the frequent buyer card bar code number would read on the generating, transmitting and identifying steps in paragraphs 5-7, for example, of claim 32, or that a red courtesy phone may be considered the claimed "personal computer." We are also not convinced that the claimed transmitting promotion data would be met by merely walking into a PerformanceBike retail store so that the information is "transmitted" to the consumer.

Since the examiner's experience is not convincing as to obviousness of the instant claimed subject matter, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 103 based on the examiner's experience with PerformanceBike.

The examiner also rejected claims 32-70 under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

As the examiner explained, at page 8 of the answer, while the claims are not identical, they are not patentably distinct from each other because "the patented feature of encoded data is an obvious variation of the application claimed token and because both perform the same function in the same manner with the same result."

It is our view that the examiner makes at least a reasonable case since the "token" of the instant claims does appear to be similar to the patented "purchasing incentive containing in encoded form the identity of the retailer designated by the customer..." In the face of this rather reasonable finding of obvious-type double patenting, appellants' sole argument is that the patented claims

define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other (principal brief-page 22).

Thus, appellants merely assert that the instant claims would not have been obvious over the patented claims but do not point to any error in the examiner's reasoning. It is not enough to

argue that the instant claims define identifying token data in a retail store when the patented claims are also clearly directed to generating purchase incentives for a retail store. Appellants have offered nothing to show any non-obviousness difference between the claimed "token" and the encoded purchasing incentive, while the examiner has made out a reasonable case that one would have been obvious over the other.

Accordingly, we will sustain the rejection of claims 32-70 over obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

Finally, we turn to the examiner's rejection of the claims "under 35 U.S.C. § 103(a) as being obvious over copending US Patent Application 09/567,274," which, as explained supra, is really a provisional rejection based on obviousness-type double patenting.

It appears to be the examiner's position that the difference between the instant claims and the claims in the copending application is in the recitation, by the latter, of the generation of redeemable vouchers, separate shopping list transmission, etc. and that the instant claims would have been obvious thereover, especially since the instant claims appear to be broader in scope.

The examiner's position does not appear to be unreasonable. Yet, appellants do not dispute the merits of the rejection. Instead, they argue only that the copending application is not prior art because it "appears from the PTO website to be unpublished" (principal brief-page 24). Appellants appear to be responding to a rejection thought to be under 35 U.S.C. § 103. However, the examiner made it clear, in the response section of the answer, that this rejection was really a provisional obviousness-type double patenting rejection. In filing a reply brief, appellants had an opportunity to respond to this rejection but, for whatever reason, chose not to do so. Thus, in effect, we have no response from appellants with regard to the rejection.

If the copending application has been, or will be, abandoned, then this rejection becomes moot. However, if the copending application remains pending with the claim language identified by the examiner, then this "provisional" rejection appears to us to be proper.

Accordingly, we will sustain this provisional rejection of claims 32-70 over copending application Serial No. 09/567,274, based on obviousness-type double patenting, as appellants have convinced us of no error in the examiner's position.

Appeal No. 2004-0989  
Application No. 09/401,939

Rejections which were previously made by the examiner but not repeated in the answer are not before us. Accordingly, contrary to appellants' request, we will not treat such rejections.

CONCLUSION

We have not sustained the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs. We also have not sustained the rejection of claims 32-70 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103 based on an obvious variation of the examiner's personal knowledge of incentives by PerformanceBike.

We have, however, sustained the rejection of claims 32-70 based on obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469, and over claims of copending application Serial No. 09/567,274.

Therefore, the examiner's decision is affirmed.

Appeal No. 2004-0989  
Application No. 09/401,939

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

*Errol A. Krass*  
ERROL A. KRASS  
Administrative Patent Judge

*Jerry Smith*  
JERRY SMITH  
Administrative Patent Judge

*Michael R. Fleming*  
MICHAEL R. FLEMING  
Administrative Patent Judge

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) APPEALS AND  
) INTERFERENCES

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Appeal No. 2004-0989  
Application No. 09/401,939

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# Appendix ~~III~~ ~~IV~~ IV

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



Paper No. 33

## UNITED STATES PATENT AND TRADEMARK OFFICE

Atty Review: 12-704

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA, ✓  
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738✓  
Application No. 09/401,198

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

### DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-67.

The invention is directed to providing shopping aids to customers through a computer network. In particular, a prompt for personal information from a main computer to a personal computer is transmitted over a network; personal information data

-1-

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Application No. 09/401,198

is transmitted over the network from the personal computer to the main computer responsive to the prompt; page data defining a web page based on the personal information is generated; and a web page address to that web page is assigned.

Representative independent claim 32 is reproduced as follows:

32. A computer implemented method for generating a web page, said method comprising the steps of:

transmitting a prompt for personal information from a main computer to a personal computer over a computer network;

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt;

generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information.

The examiner relies on the following reference:

Angles et al. (Angles) 5,933,811 Aug. 3, 1999  
(filed Aug. 20, 1996)

Claims 32-67 stand rejected under 35 U.S.C. § 103 as unpatentable over Angles.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

The examiner points to Figures 1-3, 7, and 9-11, and column 5, lines 62-67, column 6, lines 4-14, column 7, lines 19-42 and column 8, lines 10-19 and 33-67, of Angles and alleges that while these cited portions of the reference lack "explicit" recitation of all of the elements of the claim, e.g., independent claim 32, it would have been obvious to arrive at the instant claimed subject matter

because such a method supports customization "which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet...In addition, to executing the content provider script, the advertisement provider also obtains the consumer's member code from the consumer computer. The advertisement provider uses the consumer's member code to identify the consumer's demographic profile and preferences..." (See Angles (col. 4, ll. 6-14; and col. 3, ll. 53-65)). (Answer-pages 6-7).

We will sustain the rejection of claims 41-67 under 35 U.S.C. § 103 because the examiner has established a prima facie case of obviousness. We will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 because, in our view, the examiner has not established such a case with regard to the subject matter of these claims.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only identify the elements in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the instant case, the examiner merely alleges that each and every claim limitation is either taught or suggested by Angles or that the claimed subject matter would have been obvious even though the examiner points to not one of the claimed elements/steps having a corresponding teaching in the applied reference. It is unclear from the examiner's explanation, exactly what elements/steps of Angles are considered to correspond to the claimed elements/steps.

It is clear to us that Angles teaches a method of delivering advertisements to a consumer's computer and, in doing so, there is a transmission of a prompt for personal information from a main computer to a personal computer and also a transmission of personal information from the personal computer to the main computer in response to the prompt. It is clear from column 3, lines 18-28, of Angles, that the reference suggests the claimed transmission of a prompt for, and transmission of, personal information data from/to a main computer and a personal computer.

However, the examiner has never explained where, in Angles, is to be found the claimed "generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information."

We note that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyper-links to other information and that the "hyper-links typically direct the user's Internet browser to access different websites on the Internet." In our view, one may fairly interpret this disclosure as a teaching of "generating page data defining a web page based upon said personal information" since the advertisements sent to a consumer in Angles are based on personal

information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data. But, even if we accept such an interpretation, and we do, this still does not reveal where the claimed limitation of "assigning a web page address to said web page based upon said personal information" is to be found, or suggested, in Angles.

In responding to appellants' arguments, the examiner merely replies with general platitudes regarding the law on obviousness as well as "cogent reasons to modify the teachings of Angles," (answer-page 59). The examiner cites various cases, and various portions of Angles, at pages 58-69 of the answer, but the examiner never offers any specifics as to just how, exactly, specific teachings of Angles are considered to disclose or suggest the specific claim limitations, especially the limitation anent "assigning a web page address..."

Generalities are not sufficient to establish obviousness under 35 U.S.C. § 103. The examiner must give specifics as to how the prior art is applied against the claimed subject matter. "[T]he Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Similarly, the examiner must also make findings based on material facts documented on the record. Yet, the examiner, in this case, has not shown how, in accordance with the record of this case, Angles suggests "assigning a web page address to said web page based upon said personal information." The examiner may not merely allege obviousness, without finding a single claimed element/step in the reference, by stating that the disclosure of Angles "supports customization..."

At page 68 of the answer, the examiner asserts that teachings in an unapplied reference to Legarde anent associating URLs and hyper-links with assigning a web page address to a web page based on personal information, would have been "inherently disclosed in Angles in view of Legarde."

Not only is it not understood how the assigning of a web page address to a web page based on personal information can be "inherent," but the examiner appears to be basing this "inherency," indeed, basing the entire rejection, on a reference which is not even part of the statement of rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the

rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

While there may possibly be some convincing reason why the disclosure in Angles might be considered to obviate the instant claimed subject matter, within the meaning of 35 U.S.C. § 103, by somehow suggesting the claimed "assigning a web page address to said web page based upon said personal information," the examiner clearly has not provided it.

Accordingly, we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 as set forth by the examiner.

With regard to claims 41-67, we will sustain the rejection of these claims under 35 U.S.C. § 103 because these claims do not include the limitation of "assigning a web page address to said web page based upon said personal information." Rather, these claims merely recite the generation of page data defining a web page based on the personal information and the transmission of the page data. As explained, supra, we consider the disclosure of Angles, at column 4, lines 7-9, to suggest such a generation and transmission of page data.

Even where some of the claims, e.g., claim 50, recite a "personalized web page," this is considered suggested by the hyper-links in Angles because these hyper-links lead to a web

Appeal No. 2004-0738  
Application No. 09/401,198

page as a result of the personal information. Accordingly, the web pages displayed as a result may be considered "personalized web pages."

In claim 42, there is a step of "communicating a web page address for said web page" recited. However, this is different from the recitation, in claim 32, for example, of "assigning a web page address to said web page" because there is no assignation. Rather, claim 42 merely requires a communication of a web page address for a web page, which may be the web page to which the hyper-link takes the user in Angels. It does not require assigning a web page address to the web page, that was defined by the generation of page data, based upon the personal information.

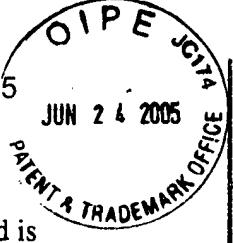
Accordingly, we will sustain the rejection of claims 41-67 under 35 U.S.C. § 103, but we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103.

The examiner's decision is affirmed-in-part.



Appeal No. 2004-0738  
Application No. 09/401,198

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## Appendix V

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

### UNITED STATES PATENT AND TRADEMARK OFFICE

#### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte MICHAEL C. SCROGGIE,  
MICHAEL E. KACABA, DAVID A. ROCHON  
and  
DAVID M. DIAMOND

Appeal No. 2004-1420  
Application No. 09/567,274 CAT/29-SCRO-CO3

#### ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

#### ON REQUEST FOR REHEARING

Appellants request that we rehear, and reconsider, our decision of August 18, 2004,  
wherein we sustained the examiner's rejection of claims 28-43 under 35 U.S.C. §103.

In particular, appellants contend that we assumed facts not in evidence as the basis for our conclusion that the examiner had established a prima facie case of obviousness. Moreover, appellants argue that although the examiner has provided no reason as to why the claimed subject matter would have been obvious, our decision merely points to the fact that appellants have not traversed the non-existent reasoning of the examiner, specifically pointing to page 8, line 17, through page 9, line 7 of our decision (see page 5 of the request for rehearing).

Moreover, appellants argue, the examiner did not point out where and how the Barnett reference made the claimed subject matter obvious and, in fact, the examiner's assertions were only sufficient to support an allegation of anticipation, not obviousness (page 5 of the request for rehearing).

We disagree with appellants.

First, it is clear, from page 3 of the answer that the examiner's reasons for rejection of the claims were based on obviousness, and not anticipation. Note that at that portion of the answer, after indicating that Barnett discloses various claimed elements, and where those disclosures may be found within Barnett, the examiner indicates that Barnett "does not specifically teach

transmitting the incentives. . . ." The examiner then goes on to state why the claimed subject matter as a whole would have been obvious, by stating that

[s]ince the e-mail address for the user is stored then it would have been obvious . . . to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user.

While the examiner specifically applied this reasoning to claims 34-43, it is clear that this reasoning is applicable to the other claims since those other claims also include the limitation of transmitting a purchase incentive to an electronic mail address.

Further, while the examiner may not have gone into as much detail as appellants desired in applying Barnett to the specifics of the claims, the examiner did, in fact, set forth a reasonable case of obviousness by indicating how each of the claimed elements is alleged to have been taught by Barnett and why the claimed subject matter would have been obvious thereover. Accordingly, the burden shifted to appellants to overcome the examiner's prima facie case by specifically pointing to some error in the examiner's reasoning.

Yet, instead of pointing specifically to error in the examiner's reasoning and showing how/why Barnett does not teach what is alleged by the examiner, appellants merely cite portions

of the claims and cavalierly contend that Barnett "does not disclose or suggest" the claimed subject matter (e.g., see paragraph d at page 7 of the principal brief) without further explanation.

When confronted with a rejection under 35 U.S.C. §103, an applicant is obliged to specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection. Moreover, the applicant should explain how such limitations render the claimed subject matter unobvious over the prior art. In the instant case, appellants have failed to explain how the cited claim limitations render the claimed subject matter unobvious. It is true that the examiner has the burden, in the first instance, to establish a prima facie case, but, once that case is established, as we hold it was here, appellants must come forward with specific arguments as to why the examiner's rationale is erroneous and why the specific claim limitations render the claimed subject matter unobvious. For the most part, appellants have not done this.

We note that arguments that appellants could have made but, for whatever reason, have not made, are waived. In re Kroekel, 803 F.2d 705, 231 USPQ 640 (Fed. Cir. 1986).

At page 6 of the request for rehearing, appellants argue that the claim limitation of "generating said purchase incentive based upon frequency of prior use of purchase incentives

generated for said identification" is not taught by Barnett. In particular, appellants argue that Barnett teaches what is stored in the database 11 and those stored elements do not include a time of prior use of a purchase incentive generated for identification.

While appellants are arguing that the "frequency of use" limitation of some of the claims is not taught by Barnett, as we said in our decision, the rejection is not one based on anticipation, but, rather, on obviousness. Therefore, the applied reference need not teach each and every element, including "frequency of use." It is only necessary that the applied reference suggests the claimed subject matter so that the artisan would have been led, from its teaching, to base the incentive generation at least in part upon frequency of use.

As we indicated in our decision at pages 11 and 12:

The cited portion of column 7 of Barnett makes it clear that distribution of user-specific data to the coupon distribution center is of value and that such data is used for marketing analysis so that subsequent coupon packages may be targeted specifically at certain users. The reference also makes it clear thereat that the coupon distribution center utilizes the user-specific redemption data along with the user-specific demographic data supplied by an online service provider in order to compile subsequent coupon data.

It appears to us that the artisan would have recognized that frequency of use or redemption is part of the user-specific data and/or user-specific redemption data taught by Barnett. Users who employ coupons more

frequently are more likely to be targets to whom coupons will be offered and the coupon issuer would be very interested in this statistic in determining whom to target. Therefore, the artisan would have found it obvious, in view of Barnett's disclosure, to base the generation of incentives at least in part, upon frequency of use or redemption of such incentives.

Appellants have offered nothing to show error in such rationale because appellants do not attack the obviousness of generating incentives based at least in part upon frequency of use or redemption; they merely state that Barnett does not disclose this.

Accordingly, we did explain in our decision why the artisan would have been led to the instant claimed subject matter and appellants have not convinced us of any error in our decision.

While appellants now argue that Barnett's teaching of periodic downloading and frequency is the inverse of periodicity, that we misapprehended the examiner's position regarding a "selected time period" and that we rely on facts not in evidence, such as "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered," appellants do not appear to point to any perceived error in our rationale for sustaining the rejections. That is, while appellants argue that we rely on facts not in evidence, appellants do not refute the allegation that "[u]sers who employ coupons more frequently are more likely to be targets to whom coupons will be offered." Further, even if, arguendo, we may have applied the



Appeal No. 2004-1420  
Application 09/567,274

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No Date Set  
1 week atty review. RAN



## Appendix VI

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

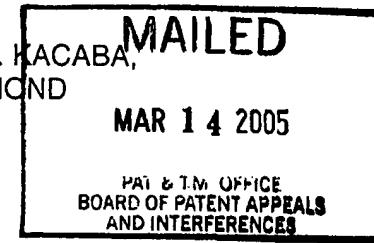
Paper No. 32

### UNITED STATES PATENT AND TRADEMARK OFFICE

#### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL C. SCOGGIE, MICHAEL E. KACABA,  
DAVID A. ROCHON and DAVID M. DIAMOND

CAT/29US-SCROCO  
Appeal No. 2004-0989  
Application No. 09/401,939



#### ON BRIEF

Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

#### ON REQUEST FOR REHEARING

Appellants filed a request for rehearing under 37 CFR § 41.52, on January 24, 2005, requesting that we reconsider our decision of November 22, 2004 wherein we sustained the rejection of claims 32-70 based on obviousness-type double patenting. We presume that appellants do not take issue with that part of our decision wherein we did not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103.

DecReqRehear-CAT29USSCROCO\_050316

Appeal No. 2004-0989  
Application No. 09/401,939

As an initial matter, appellants contend that we are not authorized by 37 CFR § 41.50 to "sustain" or "not sustain" but only to "affirm" or "reverse."

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse, or affirm-in-part, the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On more important matters, appellants contend that with respect to the rejection of claims 32-70 over related case 09/567,294, we overlooked the fact that the examiner presented a new ground of rejection in the answer, which the examiner was not permitted to do under 37 CFR § 1.193, in effect at the time of the answer. Appellants' position is that the examiner's answer, for the first time, presented the rejection as one of provisional obviousness-type double patenting over application Serial No. 09/567,274, in contrast to the final rejection which rejected these claims under 35 U.S.C. §103 as unpatentable over the claims of application Serial No. 09/567,274.

While we have considered appellants' argument, we find no actionable error in our decision. It is true that the examiner based the rejection in issue on "35 U.S.C. §103," but it is also clear from the answer, at page 8, that the examiner was really basing the rejection on "double patenting," as the rejection is listed under that heading. In any event, the rationale has been the same throughout the prosecution (viz., in the

Appeal No. 2004-0989  
Application No. 09/401,939

final rejection and in the answer) that the instant claims were not patentably distinguishable from the claims of copending application Serial No. 09/567,274. Moreover, if appellants thought that the examiner was establishing an impermissible new ground of rejection in the answer, appellants could have, and, in fact, did, file a reply brief. Therefore, we fail to see how appellants have been harmed by the examiner's possible error of using "35 U.S.C. §103" in the statement of the rejection. Yet, even though appellants filed a reply brief and, by then, it was clear, or should have been clear, to appellants what the examiner's position was regarding the provisional obviousness-type double patenting rejection, appellants chose, for whatever reason, not to respond to this rejection.

Accordingly, since we find that appellants have shown no actionable error in our decision, while we grant appellants' request to the extent that we have reconsidered our decision, the request is denied with respect to making any changes therein.

Appeal No. 2004-0989  
Application No. 09/401,939

No time period for taking any subsequent action in connection with this appeal  
may be extended under 37 CFR § 1.136(a).

DENIED

*Errol A. Krass*  
ERROL A. KRASS

Administrative Patent Judge

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BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

*Jerry Smith*  
JERRY SMITH

Administrative Patent Judge

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BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

*Michael R. Fleming*  
MICHAEL R. FLEMING

Administrative Patent Judge

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EAK/dal

Appeal No. 2004-0989  
Application No. 09/401,939

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# Appendix VII

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

## UNITED STATES PATENT AND TRADEMARK OFFICE

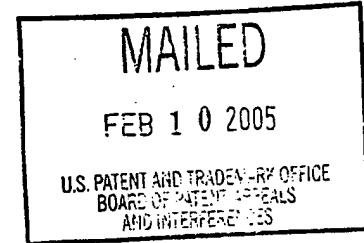
Attorney Review 2/23/05

### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, MICHAEL E. KACABA,  
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738  
Application No. 09/401,198

ON BRIEF



Before KRASS, JERRY SMITH and FLEMING, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

### ON REQUEST FOR REHEARING

Appellants request a rehearing and reconsideration of that part of our decision of November 30, 2004 wherein we affirmed the examiner's decision rejecting claims 41-67 under 35 U.S.C. § 103. Appellants do not seek rehearing on that part of our decision wherein we reversed the examiner's decision with regard to the rejection of claims 32-40 under 35 U.S.C. § 103.

Appeal No. 2004-0738  
Application No. 09/401,198

Treating paragraph II of the request for rehearing first, appellants contend that references in our decision to sustaining or not sustaining a rejection are improper since 37 CFR 41.50 authorizes the board to "affirm" or "reverse" rejections of an examiner, but not to "sustain" or "not sustain" such rejections.

In our view, "affirm" is synonymous with "sustain" and "reverse" is synonymous with "not sustain." While our final decision is to affirm, reverse or affirm-in-part the decision of an examiner, sometimes we will state that individual rejections, comprising the examiner's decision, are "sustained" or "not sustained." In any event, this "argument" by appellants is superfluous as it has no bearing on the merits of our decision or, for that matter, on anything else.

On a matter of more real concern to appellants, they argue that our affirmance of the examiner's decision with regard to claims 41-67 was not based on the same grounds as the examiner's original rejection and, therefore, we should have expressly indicated that we imposed a new ground of rejection under 37 CFR 41.50(b).

In particular, appellants assert that our reasoning that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyperlinks to other

information, that the hyper-links typically direct the user's Internet browser to access different websites on the Internet, and that therefore, Angles suggests "generating page data defining a web page based upon said personal information," is reasoning not relied upon by the examiner and, thus, our rationale for sustaining the rejection of claims 41-67 constitutes a new ground of rejection.

We have reconsidered our decision in view of appellants' comments and we do not believe that our rationale constituted a new ground of rejection. The examiner used essentially the same rationale, at page 6 of the answer, wherein it stated, with regard to the obviousness of the claimed subject matter in view of Angles, that Angles supports customization "which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet. . ." Thus, it is clear that the examiner was relying on the same rationale as we stated, i.e., that advertisements sent to a consumer's computer may contain hyperlinks to other information, and that these hyperlinks direct the user's Internet browser to access different websites. Thus, if the advertisements, which are sent to a consumer based on personal information, are said to be "page data" (i.e., the

Appeal No. 2004-0738  
Application No. 09/401,198

advertisement page contains data including a hyperlink) and the hyperlink (the hyperlink defining a web page since clicking on this hyperlink will send the user to that web page) in that page data is directed to a certain web page, it can be reasonably said that Angles generates page data defining a web page based on personal information, as claimed.

Appellants assert, at page 10 of the request for rehearing, that "a hyper-link is not a web page." It is true that the hyper link is not, itself, a web page, but clicking on the hyperlink results in a direct connection to the web page for which the hyper link is the address. Accordingly, if page data defines a hyper link, by the hyper link's inclusion in that page data, and the hyper link leads directly to a specific web page, then the generated page data may very well be said to define that web page.

Appellants also maintain that our decision does not expressly identify which claims are being discussed when we indicate that the examiner failed to make a prima facie showing, and that our statements in that regard appear to be generic and cover all the allegations in the final rejection and/or the examiner's answer (request for reconsideration-page 11).

While appellants do not identify the portion of the decision to which they refer, we assume appellants are directing the argument to pages 4-7 of our decision. Therein, we do recite various deficiencies in the examiner's case, but it is clear, from page 8 of the decision, below the listing of the deficiencies in the examiner's case, that our prior discussion related to the rejection of claims 32-40, since we summarize by saying, "Accordingly, we will not sustain the rejection of claims 32-40. . . as set forth by the examiner." Immediately, in the next paragraph, we begin to discuss our view of the rejection of claims 41-67. Therefore, a closer reading of the decision shows that we do, indeed, identify only the rejection of claims 32-40 as failing to show a case of prima facie obviousness.

At page 12 of the request for rehearing, appellants argue that our decision does not address the argument at page 7, lines 14-15, of the principal brief, wherein the examiner admitted that Angles does not expressly disclose claimed limitations.

We do not find appellants' argument persuasive. The examiner merely contended that while Angles did not expressly teach each and every element of the claimed subject matter, the claimed subject matter as a whole would have been obvious for the examiner's stated reason. Yet, at page 7 of the principal brief,

to which appellants direct our attention, there is no specific argument by appellants as to what, exactly, is the alleged error in the examiner's case. To merely state that a reference does not teach a certain claimed element, without any explanation as to the reasons deemed by appellants to distinguish the claimed subject matter over the reference disclosure, or as to the alleged errors in the examiner's case, does not constitute a convincing argument for rebutting the examiner's prima facie case.

At page 12 of the request for rehearing, appellants contend that our decision to sustain the rejection of claim 44 is at odds with our factual conclusion that Angles does not disclose or suggest assigning a web page address based upon the personal information. We disagree.

We did not sustain the rejection of the claims reciting "assigning a web page address to said web page based upon said personal information." But claim 44 is directed to the personal information comprising an identity code and that a page address for said web page depends upon said identity code. There is no direct recitation, in claim 44, of "assigning" the address for the web page based on the personal information. Thus, we find no

Appeal No. 2004-0738  
Application No. 09/401,198

inconsistency between our finding with regard to claim 44 and our finding with regard to claim 32.

At page 12 of the principal brief, appellants further argue that we misapprehended or overlooked the argument at page 9 of the principal brief, relating to the purchase history database, and that we misapprehended the examiner's incorrect conclusion regarding claim 46, that Angles' storage of a cookie containing a consumer's ID on a user's computer suggests "storing in a purchase history database data identifying products purchased in association with said identity code."

Again, we found that the examiner established a case of prima facie obviousness, which was not argued by appellants. It is not an argument for appellants to merely recite that a reference does not disclose or suggest a particular claimed feature, when the examiner has indicated that it does, without specifically pointing out the error in the examiner's reasoning. With no argument pointing to an error in the examiner's rationale, we will accept the examiner's finding as being correct. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. See 37 CFR § 41.37(c)(1)(vii).

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Similarly, appellants' "arguments" at page 9 of the principal brief (see page 13 of the request for rehearing) are not persuasive because they point to claim limitations without any specific argument as to how such limitations allegedly distinguish over the claimed subject matter. These "arguments" fail to point to any specific error in the examiner's rationale. Accordingly, we will accept the examiner's findings as being correct.

We have considered appellant's request for rehearing and reconsidered our decision in view of such request but, remaining unconvinced of any error in our decision, we deny appellants' request anent making any changes in our decision.

Appeal No. 2004-0738  
Application No. 09/401,198

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**DENIED**

*Errol A. Krass*  
ERROL A. KRASS )  
Administrative Patent Judge )  
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 )  
*Jerry Smith*  
JERRY SMITH ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS AND  
 ) INTERFERENCES  
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 )  
*Michael R. Fleming*  
MICHAEL R. FLEMING )  
Administrative Patent Judge )

EK/RWK

Appeal No. 2004-0738  
Application No. 09/401,198

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NEIFELD DOCKET NO: CAT/29US-SCRC03

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 6599

Michael C. SCROGGIE et al.

US APPLICATION NO: 09/756,788

FILED: January 10, 2001

GROUP ART UNIT: 3622

EXAMINER: JANVIER

TITLE: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

37 CFR 1.143 RESPONSE TO SECOND ELECTION OF SPECIES REQUIREMENT

Sir:

In response to the office action mailed April 18, 2005, the applicant responds as follows:

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## I. The Restriction Requirement

In the office action mailed April 18, 2005, the examiner stated that:

Restriction to one of the following inventions is required under 35 USC 121:

- I. Claims 32-37, 59-75, 50-56, 76-91 and 58, drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site **and means for delivering purchasing incentives to consumers by e-mail (disclosed at least in independent claim 32)**.
- II. Claims 44-49 drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site **and means for delivering by e-mail notices to said consumers to purchase a specific manufacturer's product (disclosed at least in independent claim 44)**.
- III. Claims 38-43, drawn to a method of and system for delivering incentives over the Internet comprising a Web site for providing purchasing incentives from multiple sources, a consumer purchase history database based on consumer online shopping activity, a consumer database, which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data

from said Web site and means for delivering by e-mail notices which remind consumers to visit said Web site (disclosed at least in independent claim 38).

IV. Claim 57, drawn to a method of and system for providing, via a Web site, purchasing incentives from multiple sources such as retailers and manufacturers comprising a personal database, a consumer purchase history database based on consumer online shopping activity, **means for generating a web page with a consumer-specific display and means for updating said web page.**

Comments:

In Group II, it appears that means for delivering by e-mail notices to said consumers to purchase a specific manufacturer's product, recited in claim 44, is equivalent to delivering a purchase incentive to a consumer via e-mail, as disclosed in Group I, whose content is subsequent [sic] printed to obtain a paper coupon having the designated manufacturer's product name and/or UPC code imprinted thereon. Further, in Group IV, it appears that **means for informing the consumer by e-mail of new incentives**, as disclosed in claim 57, is equivalent to notifying the consumer by e-mail to visit the Web Site and access his personal web page to view new incentives available to him. If the Applicant agrees with these interpretations, as supported in the specification, then the Applicant can contact the Examiner to discuss ways to amend claims 44 and 57 respectively so that Group I and II, Group III and IV can be respectively examined together. That is, Group I and II will form one group and Group III and IV will another [sic] different group.

Meanwhile, the inventions are distinct, each from the other because of the following reasons:

For example, Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be

shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate search and hence, restriction for examination purposes as indicated is proper. [Office action mailed April 18, 2005 page 2 line 11 through page 5 line 13.]

## **II. Provisional Election with Traverse**

In response, the applicant provisionally elects group I, claims 32-37, 50-56, and 58-91 **with traverse.** The applicant traverses the requirement because the requirement does not comply with authority binding upon the examiner for the many reasons noted below.

The MPEP is binding upon the examiner insofar as it is the procedural requirements imposed on the examiner by the Director. Therefore, a restriction requirement that fails to comply with the MPEP is improper and should be withdrawn. Cf. In re Portola, 110 F.2d 786, 788, 42 USPQ2d 1295, \_\_\_\_ (Fed. Cir. 1997).

## **III. The Restriction Requirement is After Final Action**

MPEP 802 Basis for Practice in Statute and Rules states in pertinent part that:

37 CFR 1.142 Requirement for restriction.

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a

requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action. [Emphasis supplied.]

The plain meaning of the emphasized portion of 37 CFR 1.142 cited above is that a request for restriction cannot be made after final action. The passage "Such requirement will normally be made before any action on the merits;" indicates the normal course of action. The passage "however, it may be made at any time before final action" is a catch-all description for the timing of a restriction requirement. MPEP 802 Basis for Practice in Statute and Rules makes no provision for a restriction requirement after final action.

Moreover, MPEP 818.03(a) Reply Must Be Complete, quoting 37 CFR 1.111(b) states in pertinent part that:

The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. . . .

By stating that an applicant's reply to a restriction requirement must advance the proceeding to final action, MPEP 818.03(a) indicates that a restriction requirement must be made before final action.

The subject restriction requirement was imposed after a first restriction requirement mailed October 29, 2004, after a second final action mailed May 4, 2004, after a first final action mailed September 17, 2003, after a first appeal brief in response to the first final action mailed September 17, 2003, and after request to reinstate the appeal and second appeal brief in response to the second final action mailed May 4, 2004. Therefore, a restriction requirement, which was made after final action, is improper and should be withdrawn.

IV. **No Burden on Examiner for a Search and Examination of an Entire Application**

A. **The Restriction Requirement Fails to Comply with MPEP 803**

1. **MPEP 803 Restriction - When Proper**

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The applicant points out that the examiner has not shown that examining invention groups I, II, III, and IV, in this application imposes a serious examination burden.

Given the erroneous analysis as to combination/subcombination and the scope of claimed subject matter, and the absence of separate classifications, the election requirement is improper and should be withdrawn.

Given that the examiner has been working on all claims in this application and the application has twice been finally rejected, there appears to be no possibility of any significant burden in continued examination, particularly after appeal. Regarding the requirement of a separate search necessitating the restriction requirement, the examiner states that:

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate status and hence, restriction for examination purposes as indicated is proper. [Office action mailed April 18, 2005 page 5 lines 11-13.]

However, the examiner presents no support for the factual predicate as to why a separate search is required. For this additional reason, the election requirement is improper and should be withdrawn.

2. **MPEP 803 Guidelines**

In its Guidelines section, MPEP 803 states that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02.

MPEP 808.02 states that:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

**(A) Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

**(B) A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing parents which are evidence of such separate status, and also of a separate field of search.

**(C) A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has concluded that the inventions are distinct, stating in the office action mailed April 18, 2005 on page 5 lines 7-13:

... In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page.**

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate search and hence, restriction for examination purposes as indicated is proper.

The examiner has not met the serious burden for purposes of the initial requirement, of showing by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02, Therefore, the applicants assert that the election of species requirement is improper and should be withdrawn.

#### **B. The Restriction Requirement Runs Counter to MPEP 706.07**

MPEP 706.07 states the conditions precedent to final rejection or action. MPEP 706.07 states in pertinent part that:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be **thoroughly searched in the first action** and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. [Emphasis supplied.]

\* \* \*

While the rules no longer give to an applicant the right to "amend as often

as the examiner presents new references or reasons for rejection," **present practice does not sanction hasty and ill-considered final rejections.**

[Emphasis supplied.]

\* \* \*

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be **clearly developed** to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection. [Emphasis supplied.]

The three passages above from MPEP 706.07 reinforce the assertion that a thorough search and examination of an entire application must be performed prior to final action. Since the examiner is required to perform a thorough search and examination of an entire application prior to final action, the search and examination has already been performed and there is no serious burden on the examiner for a search and examination of an entire application after final action as specified above by MPEP 803. Therefore, the restriction requirement is improper and should be withdrawn.

### **C. The Restriction Requirement Runs Counter to MPEP 811**

MPEP 811 dictates the time for making a requirement for restriction, stating in pertinent part that:

Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The examiner has not justified that there is a serious burden if restriction is not required. The examiner's assertion that a separate search is required is untenable, since according to MPEP 706.07 (cited above), a complete search must be performed prior to issuing a final action.

Since the examiner has not shown a serious burden if restriction is not required, the election requirement is improper and should be withdrawn.

**V. The Restriction Requirement is Improper Based on the Totality of the Examiner's Conclusions in the Two Separate Restriction Requirements**

In the initial restriction requirement mailed October 19, 2004, the examiner had grouped claims 32-56 and 59-91 as the same invention. This grouping includes all of the pending claims, except for claims 58 and 59.

In the current restriction requirement mailed April 18, 2005, the examiner has grouped claim 58 as an invention with claims 32-37, 50-56, and 58-91. Thus, claim 58 is grouped with claims 32-37, 50-56, and 59-91.

Also in the current office action mailed April 18, 2005, the examiner admits (1) that it appears that Group I is equivalent to Group II and (2) that it appears that Group III is equivalent to Group IV (office action mailed April 18, 2005 page 4 lines 6-19). The examiner's latter admission implicitly groups claim 57 in the same invention as claims 38-43.

Therefore, by combining the examiner's groupings and admissions from the two separate restriction requirements, every pending claim has been grouped with or by the examiner's admission is equivalent to one of the claims from Group I of the restriction requirement mailed October 19, 2004.

Therefore, based on the examiner's grouping and admissions, there is no distinction among any of the pending claims, restriction for examination purposes is not proper.

**VI. The Restriction Requirement Fails to Comply with MPEP 816**

MPEP 816 states that:

**816 Give Reasons for Holding of Independence or Distinctness**

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part.

Each other relationship of claimed invention should be similarly treated and the reasons for the conclusions of distinctness of invention as claimed set forth.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

The applicant points out that, with respect to the group I claims, the examiner has not pointed out "the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part."

Specifically, the examiner provides no rationale for why the combination as claimed does not require the particulars of the subcombination as claimed [Office action mailed April 18, 2005 page 5 lines 7-8.] Therefore, there is no support for the factual predicate upon which the examiner bases the restriction analysis.

Moreover, the examiner has not classified the groups of the alleged four inventions, as specified in MPEP 816.

Furthermore, the examiner has not provided reasoning with respect to Invention I and Invention II, Invention I and Invention III, Invention I and Invention IV, Invention II and Invention III, Invention II and Invention IV, and Invention III and Invention IV indicating why the examiner believes these inventions are legally distinct.

Therefore, the restriction requirement is improper and should be withdrawn.

## **VII. The Restriction Requirement Fails to Comply with MPEP 817**

MPEP 817 states that:

### **817 Outline of Letter for Restriction Requirement Between Distinct Inventions**

The statement in MPEP § 809.02 through § 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

#### **OUTLINE OF LETTER**

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121

- (1) Identify each group by Roman numeral.
- (2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.
- (3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product.
- (4) Classify each group.

The examiner has not given a "short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product," as required by MPEP 817.

Additionally, the examiner has not classified the groups of the alleged four inventions, as specified in MPEP 817(4).

Moreover, the examiner has not shown that any of the four groups meet any criteria for restriction relative to the other group, as required by MPEP 817.

Therefore, for all the foregoing reasons, the restriction requirement is improper and should be withdrawn.

#### **VIII. The Serious Burden Placed Upon the Applicants by the Requirement**

The applicants request that the examiner keep in mind the serious (and often unnecessary) financial burden placed upon *the applicants* in having to split prosecution between division applications in response to restriction requirements, particularly at this late stage of prosecution. Given the applicant's reliance in filing a response to two restriction requirements, two appeal briefs, and the examiner's undue delay in asserting an office action necessitating the current requirement for restriction, the applicant asserts that the doctrines of equitable estoppel and laches apply. Accordingly, the applicant requests that the examiner vacate the restriction requirement, as being equitably improper under the doctrines of reliance estoppel and laches.

#### **IX. Closure**

For all of the foregoing reasons, the election requirement is improper and should be vacated. Therefore, the examiner should withdraw the restriction requirement and proceed to examine the application for compliance with all other statutory requirements.

Should Examiner Janvier have any questions, the examiner is urged to contact the undersigned at (703) 415-0012.

6/22/2005

Date

Respectfully Submitted,

Richard A. Neifeld, Ph.D.  
Registration No. 35,299  
Attorney of Record

BTM

Printed: June 22, 2005 (2:38pm)

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